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Trademark Law

September 26, 2001

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Washington, D.C. 20231

Re: **Application Serial No.:** 08/889,033  
**Appellants:** Frazzitta, et al.  
**Title:** Transaction System  
**Docket No.:** D-1083

Sir:

The Appellants hereby request reinstatement of the appeal. Please find enclosed, in triplicate, Appellants' Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192 in response to the Office Action dated July 26, 2001 for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Supplemental Appeal Brief and any other fee due to Deposit Account 04-1077.

Very truly yours,



Ralph E. Jocke  
Reg. No. 31,029

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of )  
Bartholomew J. Frazzitta, et al. ) Art Unit 2613  
Serial No.: 08/889,033 )  
Filed: July 7, 1997 ) Patent Examiner  
Title: Transaction System ) Tung Vo

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OCT 4 2001

Board of Patent Appeals and Interferences  
Commissioner of Patents and Trademarks Technology Center 2600  
Washington, D.C. 20231

**SUPPLEMENTAL BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby request reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

**REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

#21 / Supp /  
Appeal /  
Brief /  
D-1083 /  
(in triplicate) /  
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## **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-47 are pending in the Application.

Claims 1-4, 12-13, 18-19, 24-27, 37-42, and 47 were rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale et al. ("Casale") in view of Bustos.

Claims 5-11, 14-16, 20-23, 28-36, and 43-46 were rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale et al. ("Casale") in view of Bustos and McClure et al. ("McClure").

Claim 17 was rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale in view of Bustos and McClure and further in view of Kaehler.

These rejections were the only rejections present in the Office Action ("Action") dated July 26, 2001. Appellants appeal the rejection of claims 1 through 47, inclusive.

## **STATUS OF AMENDMENTS**

The following dates and papers are associated with this application:

1. 10/06/99 Non-final Rejection
2. 01/06/00 Applicants' Response
3. 03/07/00 Non-final Rejection
4. 05/11/00 Applicants' Response

5. 07/17/00 Final Rejection
6. 08/04/00 Request for Withdrawal of Premature Final Rejection
7. 10/05/00 Notice of Appeal
8. 01/03/01 Appeal Brief
9. 05/07/01 Final Rejection
10. 05/21/01 Petition that an Examiner's Answer (Action dated 05/07/01) contained an impermissible new ground of rejection (and a Premature Final Rejection)
11. 07/03/01 Reply Brief
12. 07/26/01 Non-final Rejection

As the record indicates, claims have been rejected five times. Presently the application is not under final rejection. Thus, no amendments to the claims were requested to be admitted after a final rejection.

In the maze of confusion caused by the Office's diverse actions and lengthy prosecution, including whether prosecution has ever been properly reopened, Appellants simply desire to continue with their appeal. Thus, Appellants request reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). Note MPEP § 1208.02.

## **SUMMARY OF INVENTION**

### **Overview of the Invention**

An exemplary embodiment of the present invention is directed to a system (10) for carrying out transactions. The system may include customer stations (18) and a service provider (SP) station (14). Each customer station (18) is enabled to be operated by a customer requesting a transaction. The SP station (14) is enabled to be operated by a service provider such as a cashier, clerk or teller, who carries out the transaction. The system may be confined within a building (12) and may provide better service and enhanced security by separating the customer stations and the service provider station.

Exemplary embodiments may use a single service provider to service several customer stations, and enables servicing the customers in the proper order despite the fact that customers may approach different customer stations. The building (12) which houses an exemplary embodiment comprises an interior area which includes an interior wall. The SP station is housed in the interior area. At least one component of the customer station may also be positioned within the interior area of the same building. The SP station may be located in a secure room (36) within the building.

In exemplary embodiments audio and video communications may be established between customers at the customer stations and the service provider at the SP station. Items may be exchanged between customers and the service provider through carriers (26). The carriers (26) may be transmitted through a pneumatic tube system (22). A video material presentation device (50) may be provided to present promotional or other video material on displays at the customer

stations. Video material may be presented to customers while the customer station is not in active communication with the service provider station. The customer stations may be readily installed and configured in the transaction facility to maximize the floor space available for other purposes.

## **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1-4, 12-13, 18-19, 24-27, 37-42, and 47 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Casale in view of Bustos.
- 2). Whether Appellants' claims 5-11, 14-16, 20-23, 28-36, and 43-46 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Casale in view of Bustos and McClure.
- 3). Whether Appellants' claim 17 is unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Casale in view of Bustos and McClure and further in view of Kaehler.

## **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Each of Appellant's claims 1-47 recite at least one element, combination of elements, or step not found or suggested in the Casale, Bustos, McClure, or Kaehler references, which patentably distinguishes the claims.

Every claim recites additional features of the invention which patentably distinguishes the claim over every other pending claim.

The pending claims include seven independent claims (claims 1, 28, 38, 41, 43, 45, and 47). Claims 2-27 and 39-40 depend from claim 38. Claims 29-37 depend from claim 28. Claim 42 depends from claim 41. Claim 44 depends from claim 43. Claim 46 depends from claim 45.

The pending claims are reproduced in the Appendix.

## **ARGUMENT**

### **The Applicable Legal Standards**

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish *prima facie obviousness*, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142).

### **The Casale Reference**

The reference to Casale is directed to a fast food facility. The facility includes a building (10) having a base level housing (12) and a second level housing (14). The base level housing (12) includes walk-up windows (20) and drive-up windows (22). The second level housing (14) is positioned atop the base level housing (12) and extends outward over drive-up lanes (16, 18). Food is prepared in the second level housing (14), conveyed to service personnel in the base level housing (12), and handed to an outside patron via a window (20, 22) (col.6, lines 58-68). The ground contact of the base level housing (12) is small, about the size of two typical parking spaces joined end-to-end. Thus the space needed for the building is minimal (col. 5, lines 42-46).

Figures 12 and 13 show a menu and display unit disposed on the lot containing the building (10), preferably in the drive-up lanes (16, 18). The unit includes an inner housing (52) and an outer housing (50). The unit includes a speaker/microphone (58) and a menu (60). A monitor (62) permits displaying the cashier. Likewise, a camera may be positioned on the unit enabling the cashier to view the patron. The inner housing (52) is proportioned and decorated to look like a giant aluminum soft drink can.

A conveyor (90) transports the food to the lower level (12) via ramps (96, 97, 97'). As shown in Figures 9-11, the conveyor (90) includes a pneumatic column (102) providing support



and motive force for a delivery unit (104) which slides up and down the column (102). The delivery unit (104) includes a tray (108). As the delivery unit (104) falls and approaches the delivery position, an ejection/retraction gear (112) engages an ejection/retraction strip (114) causing the gear (112) to drive belts (110) forward and thereby eject the tray (108) onto a ramp (96, 97). At its lowest point, the delivery unit (104) engages an activation switch (116), which causes compressed air to drive the delivery unit (104) back up to its home position. A worker in the second level housing (14) prepares the food package, places the package on the tray (108), then hits an activation switch releasing the delivery unit (104) to travel downwardly. Alternatively, the conveyor (90) may comprise a roller and belt assembly as shown in Figures 14-15. Beverages, ice, and cups are provided to the base level housing (12) from the upper level housing (14) by means of a multi-purpose column (28). As shown in Figure 15, the ramps (96, 97) wrap around on either side of the column (28) to create two serving stations (col. 8, lines 29-33). As seen in Figures 7 and 8, the column (28) permits two order takers/cashiers to be working simultaneously, one for each walk-up/drive-up window (20, 22)(col. 8, lines 19-22).

### **The Bustos Reference**

The reference to Bustos is directed to a vending system with pneumatic product delivery. Bustos relates to the vending of individually packaged products such as beverages or other items of food, and to the accounting for payment for such vended products. The system acts as an extended vending operation delivering products one-way from the vender to the customer.

As shown in Figures 1, 2, 3A, and 3B the pneumatic delivery system (30) includes a tube (26) which extends from a storage unit (25) within a store building (15) to a dispensing unit (20). A carrier (31) is contained within the tube (26). During normal operation the carrier is not removable from the tube (col. 8, lines 66-67). The tube has a single loading end (32) and a single discharge end (33) (col. 9, lines 3-8). Vacuum pumps (41, 68) are operated to pneumatically move the carrier between the store building (15) and dispensing unit (20).

The carrier is arranged to transport a product container (40) (e.g., beverage container) one-way from the loading end (32) to the discharge end (33). As shown in Figures 3A and 3B the carrier (31) includes a plunger (45) slidably mounted in a body (44). The plunger (45) slides freely in the body (44) between stops (46) so as to be drawn to the low pressure side of the carrier and thus locate itself at the leading end of the carrier as the carrier is pneumatically forced through the tube. The plunger (45) provides both a seal to facilitate movement of the carrier and a support for the bottom of the product container (40) held in the carrier.

When a carrier has arrived at the dispensing unit (20) it is locked (72) in position so that the product container (40) can be unloaded. A piston (74) moves upward in contact with the plunger (45) lifting the container into alignment with a window (61). A door opening mechanism (66) is actuated to open the door (65) so that the product container can be removed by the customer.

For return of the empty carrier to the store building (15) the door (65) is closed, a vacuum in the tube draws the plunger (45) to the top of the carrier (31) where it rests against the stop (47) (Figure 3B). Then the pressure differential on the plunger (45) causes the empty carrier to be

forced upwardly in the tube toward the store building. The carrier may be stored to await another order. A loading ram (57) is used to push a product container (40) into the carrier. During carrier loading the plunger (45) is forced to the end of the carrier by the loading ram. Spring clips (82) may be used to hold the product (40) in the carrier (31).

A main controller (80) controls the conveyor controller (36) and the loading mechanism controller (55) to cause delivery of the product to the customer (col. 11, lines 59-62).

Customers may use a panel (22) and a card reader (18) to place and charge orders to a charge account (col. 11, lines 48-53).

### **The McClure Reference**

The reference to McClure is directed to service facilities and equipment. More particularly, it deals with a closed circuit television and pneumatic tube dispatch system for the servicing of bank customers who are located at a customer service facility outside the bank. The facilities include an exterior customer station (10) for use by a customer (12) in an automobile (14), and an interior bank station (18) located within the bank and operated by a bank teller (20). The customer station (10) includes a camera (22), TV receiver (29), and a speaker and microphone unit (31). The teller station (18) includes a camera (30, 30'), TV receiver (24, 24'), and a speaker and microphone unit (32, 32'). The teller station (18) may service plural customer stations (I and II). Pneumatic conveyor tubes (42) permit two-way dispatch of material in a capsule (40) between the operator station (18) and a customer station (10).

### **The Kaehler Reference**

The reference to Kaehler is directed to a fuel dispenser/operator intercom system. The apparatus is for installation in a retail setting for selling fuel and other non-fuel products. The apparatus allows a customer, when pumping fuel into a vehicle, to consider and decide to purchase non-fuel products presented to the customer over a video display screen (32) and menu item board (46) located on the fuel dispenser housing (12). The apparatus may combine external advertising and promotional capabilities with the added personal interaction associated with operator attended drive-through service/product transactions. An operator is located at a data entry terminal (26). After the conclusion of a sale for a non-fuel product the customer receives a printed receipt. The customer then takes the receipt to a product delivery window, presents the receipt, and receives the additional ordered merchandise (col. 1, lines 49-52; col. 4, lines 36-42; col. 7, lines 47-49).

#### **(iv) 35 U.S.C. § 103**

The Appeal Brief filed January 3, 2001 and the Reply Brief filed July 3, 2001 are incorporated by reference as if fully rewritten herein. Appellants' remarks in the amendment filed May 11, 2000 are also incorporated by reference herein.

In the Appeal Brief filed January 3, 2001 Appellants showed that claims 1-16 and 18-47 were allowable over Casale in view of Bustos and McClure. Appellants respectively submit that this Supplemental Appeal Brief meets the lesser burden of showing that claims 1-4, 12-13, 18-19, 24-27, 37-42, and 47 are allowable over only Casale in view of Bustos.

Appellants' arguments against the prior art rejections are based on the Office's interpretation of the references as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the references by the Office would constitute a new grounds of rejection.

**The Pending Claims Are Not Obvious Over  
Casale in view of Bustos**

Claims 1-4, 12-13, 18-19, 24-27, 37-42, and 47 were rejected under 35 U.S.C. § 103(a) as obvious over Casale in view of Bustos. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

Appellants hereinafter show that neither Casale nor Bustos taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. Furthermore, even if it were somehow possible for the references to have disclosed certain features as alleged, it would still not have been obvious to have combined the references as alleged. Additionally, even if it were somehow possible for the references to be combined as alleged, the combined references would still not have produced Appellants' claimed invention.

The most recent Action (July 26, 2001) refers to a previous Office Action (dated March 7, 2000) which alleged that Casale discloses a building (10); an SP station (14); SP visual display,

SP CCTV camera, SP audio transmitting device and receiving device (col. 2, lines 27-56); SP delivery and receiving device (90); customer station (12); customer visual display (62); customer audio transmitting device and receiving device (58); customer carrier delivery (90); and customer frame and an opening (22).

However, the current Action now vaguely states that Casale shows that a “customer station is on the side at lower level (ground level) of the building (10).” Thus, the element (and its exact location) which now constitutes the alleged “customer station” in Casale is unclear. Thus, it is unclear whether the alleged customer station remains Casale’s base level housing (12) in the building (10).

The current Action further alleges that Casale discloses a carrier (conveyor trays) (94).

The Action (page 6) admits that in Casale “the customer station is on the side of the building but it is not inside the building as claimed.” In Casale there is no customer inside the small building (col. 5, lines 41-46), so there also is no customer station (or a customer station component) positioned inside the building. Thus, the Action is correct in admitting that Casale does not disclose a customer station (or a customer station component) positioned inside of a building. It follows that the Action by inference also admits that Casale does not disclose an SP station and a customer station (or a customer station component) positioned inside of the same building.

The Action alleges that Bustos teaches having customer stations (104, 115-118; Figure 5D) inside a building. The Action further alleges that it would have been obvious “to apply the

teachings of Bustos into Casale for constructing the customer stations as shown in fig. 5D inside the building.” The Appellants disagree, as discussed in more detail hereinafter.

**The Independent Claims Are Not Obvious Over  
Casale in view of Bustos**

The rejected claims include the independent claims 1, 38, 41, and 47. It is respectfully submitted that these claims are allowable over Casale in view of Bustos.

**Claim 1**

Claim 1 is specifically directed to a “transaction system.” The claim recites an “SP station” and a “customer station” positioned inside of the same building. The claim further recites that “the SP station is enabled to be operated by a service provider providing a transaction.” The claim further recites that “the customer station is enabled to be operated by a customer requesting a transaction.” The claim further recites that the SP station includes positioned therein an “SP carrier delivery and receiving device.” The claim further recites that the customer station includes positioned therein a “customer carrier delivery and receiving device.” The claim further recites that the carrier delivery and receiving devices are in “operative connection” with each other. The claim further recites that “a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device.”

The Action admits that Casale does not disclose a customer station (or a customer station component) positioned inside of a building, or an SP station and a customer station positioned

inside of the same building. However, it is respectfully submitted that Casale lacks many more of the recited features and relationships than the Action indicates. Thus, even if it were somehow possible for Casale to be combined with Bustos as alleged, the secondary reference would still not alleviate all of the deficiencies in Casale. It is respectfully submitted that Casale does not disclose or suggest:

- 1). • “the SP station and the customer station are positioned inside of the building.”  
The Action admits that Casale does not disclose an SP station and a customer station positioned inside of the same building.
- 2). • an “SP carrier delivery and receiving device” and a “customer carrier delivery and receiving device.”
- 3). • “the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device.”
- 4). • “a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device.”

#### Feature 1

It is respectfully submitted that Casale does not disclose having the recited SP station and the recited customer station in the same building. The claim recites that “the customer station is enabled to be operated by a customer requesting a transaction.” As previously discussed, the Action is vague as to what particular component in Casale allegedly constitutes the specifically



recited “customer station.” The Action merely states that the customer station is on the side at the lower ground level of the building (10). The Action is also silent as to what constitutes the recited at least one customer station component. However, a previous Action referred to a customer visual display (62) and a customer speaker/microphone (58). As seen in Figure 13 of Casale, these components are located at the menu and order display unit inner housing (52) which is distant from and outside of the building (10). (Col. 6, lines 3-7).

The inner housing (52) is used by a customer or patron to place their fast food order. The inner housing (52) is separate from the alleged customer station (i.e., on the side at lower ground level of the building 10) and the alleged SP station (second level housing 14). The inner housing (52) is part of a menu and display unit disposed on the lot containing the fast food building (10), preferably in the drive-up lanes (16, 18). The inner housing (52) is disposed remotely at a distance from the pick-up window (22). The inner housing (52) is plainly not positioned in a building. Hence, the inner housing (52) cannot constitute the recited customer station.

The arrangement of Casale is similar to known drive-thru fast food establishments where the customer first places their order at a menu location (52), then drives to the pick-up window (22) to pay for and receive the items in their previously placed order. Therefore, the transaction occurs by hand at the pick-up window (22). There is no delivery device at the inner housing (52). Since the food is handed to the customer at the window, there is also no need for a delivery device at the window. Nor is there at least one of a camera, display, audio receiving device, or audio transmitting device at the pick-up window (22).

The inner housing (52) cannot constitute the recited “customer station” because it is not located inside the building. Likewise, the pick-up window (22) cannot constitute the recited “customer station” because it is not located inside the building, nor does it include the recited customer component of at least one camera, display, audio receiving device, or audio transmitting device. It follows that Casale does not disclose or suggest a customer station (as recited) positioned inside of a building. Not only does Casale lack a customer station positioned inside of a building, but Casale also does not disclose or suggest a “customer station” in the manner recited.

Furthermore, Casale’s base level housing (12) cannot constitute the recited customer station. The base level housing (12) does not meet the recited features of the claimed customer station. Casale, as discussed in more detail hereinafter, does not disclose a customer station having a customer carrier delivery and receiving device, or that a carrier is enabled to be selectively moved with a transaction item between the customer station and the SP station. Nor does Casale disclose or suggest that the base level building housing (12) is “enabled to be operated by a customer requesting a transaction.” Casale indicates that the cashier or person taking the order (e.g., the service provider) is clearly in the base level housing (12) (col. 6, lines 29-33), but a customer is not. The customers in Casale remain outside of the building (10, 12, 14), as discussed in more detail hereinafter. Thus, Casale’s base level housing (12) cannot constitute the recited customer station.

The Action alleges that Casale discloses an SP station (14). The Appellants disagree. Casale does not disclose an SP station as alleged. The alleged second level housing (14) does not

meet the recited features of the recited SP station. It follows that Casale does not disclose or suggest a recited SP station, and the recited feature that customer station is positioned inside of the same building as the SP station. Casale does not disclose or suggest that the second level housing (14) has a visual display, camera, audio transmitting device, or audio receiving device as recited in Appellants claim 1. The second level housing (14) also lacks the recited SP carrier delivery and receiving device, as discussed in more detail hereinafter. Also, the cashier or person taking the order (e.g., the service provider "providing a transaction") is clearly in the base level housing (12) (col. 6, lines 29-33), not the second level housing (14). Therefore, the second level (14) of Casale does not meet the features and relationships of the recited "SP station".

Even the Action itself admits that Casale does not disclose an SP station and a customer station positioned inside of the same building. Therefore, Casale does not disclose that "the SP station and the customer station are positioned inside of the building" in the manner recited.

#### Features 2, 3, and 4

It is further respectfully submitted that Casale does not disclose an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device"; or that "the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device"; or that a "carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device."

The Action alleges that Casale discloses an SP station (second level housing 14) and a customer station (i.e., on the side at lower ground level of the building 10). However, there is no

indication in Casale that a carrier is enabled to be selectively moved with a transaction item from the alleged customer station to the alleged SP station (14). Nor is there any indication in Casale that the alleged SP station (14) has an SP carrier delivery and receiving device for receiving a carrier with a transaction item delivered from the alleged customer station. Nor is there any indication of a separate carrier delivery and receiving device in each station which moves transaction items between customers and service providers at the respective stations.

The Action alleges that a carrier (conveyor trays 94; Figure 14) is able to be selectively moved with a transaction item (food products). The Appellants disagree. The alleged carrier (94) in Casale is not capable of being moved with a transaction item between a customer station and an SP station. The Action states that the food products constitute the transaction item. However, even if food products in Casale constituted a transaction item, it is respectfully submitted that the alleged transaction item (food product) is not capable of being moved from the alleged customer station (i.e., on the side at lower ground level of the building 10) up to the alleged SP station (14) by using the alleged carrier (tray 94).

First, Casale does not disclose or suggest an “SP carrier delivery and receiving device” or a “customer carrier delivery and receiving device.” It follows that Casale does not disclose or suggest an SP carrier delivery and receiving device in “operative connection” with a customer carrier delivery and receiving device. Thus, movement of food products would not occur as alleged.

Secondly in Casale, the hinged trays (94) which are used for delivering food from the second level of the building to the first level, point downward during the upward trip back to the

second level (col. 8, lines 14-16; Figure 14). Thus, the alleged carrier (94) is not capable of carrying or moving a food product upward to the alleged "SP station" on the upper level (14) as alleged. Thus, Casale does not disclose or suggest the capability of a transaction item being selectively moved from the customer station to the SP station in the manner recited.

Furthermore, it would not have been obvious for Casale to have even attempted sending a food product (which was prepared in the second level housing 14) from the alleged customer station up to the alleged SP station (14) on the second level.

Bustos does not disclose or suggest the recited features lacking in Casale, nor would it have been obvious to have modified Casale with the teachings of Bustos

It is respectfully submitted that Bustos lacks many of the recited features and relationships. Furthermore, Bustos does not disclose the recited features as alleged in the Action. Thus, even if it were somehow possible to have included features of the Casale reference with the alleged features in Bustos, a modified Casale would still lack the recited features and relationships, as discussed in more detail hereinafter.

The Action alleges that Bustos teaches having customer stations (104, 115-118; Figure 5D) inside a building. The Action further alleges that it would have been obvious "to apply the teachings of Bustos into Casale for constructing the customer stations as shown in fig. 5D inside the building" of Casale. The Appellants disagree.

Casale desires customers to remain outside of the building

As previously discussed, the arrangement of Casale is similar to well known drive-thru fast food establishments where the customer first places their order at a menu location (52), then

drives to the pick-up window (22) to pay for and receive their previously placed order. Casale desires, and the structure of the building is specifically designed so that the customer always remains outside of the building. Casale does not have an interior customer station for good reason -- customers are not permitted in the building. Even if Bustos disclosed the recited customer station components, it would not have been obvious to have placed a customer station inside of Casale's building (10) as alleged.

It should be noted that Casale refers to a "customer" in the statement "The prepared and cooked pizza is cut and placed in a container for sale to the customer . . . so that the module operator receiving the order can serve it to the patron through one of the windows" (col. 6, lines 61-68). Thus, Casale acknowledges (and one having ordinary skill in the art would recognize) that a customer in the Casale reference does not 1) cook the food, or 2) place the food for sale, or 3) receive an order, or 4) serve the food, or 5) come interior of a building window. In conclusion, based on Casale's own teachings, the customer remains outside of the building.

Casale's building is not structurally capable of supporting an interior "customer station"

Casale's building (10) is too small in size to support an interior customer station. The ground contact of the building (10) is small, "about the size of two typical parking spaces joined end-to-end" (col. 5, lines 42-46). The space needed for the building and its operation is designed as minimal. The arrangement and size of the building permits only two order takers/cashiers to be working simultaneously, one for each walk-up/drive-up window (20, 22) (col. 8, lines 19-22). Thus, there is simply no space available to include a "customer station" inside of Casale's building (10). Therefore, it would not have been structurally possible to have added a "customer

station” (alleged as a hotel room (104) in Bustos) to the inside of Casale’s building (10). Nor has the Action explained how the alleged customer station (i.e., hotel room) of Bustos could have been inserted inside of Casale’s small building (10). Casale strongly desires to maintain the building of minimal size. The small building (10) is readily set up and removed (Abstract), and transportable on a single truck bed in two parts (col. 5, lines 28-38). Thus, any attempt to dramatically increase the size of the building (10) would go directly against the explicit teaching of the Casale reference and would destroy the advantages and utility of the system disclosed therein. That is, the alleged modification to Casale would destroy the utility or operability of the Casale teaching. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Thus, the Office has not presented a *prima facie* showing of obviousness.

Casale has no need of the recited “customer station”

Even if a customer were somehow permitted into Casale’s building (10)(which one isn’t), that customer would have no need of a “customer station” having a visual display, camera, audio transmitting device, or audio receiving device. Nor would a customer inside of Casale’s building (10) have any need of a system having a customer carrier delivery and receiving device in operative connection with an SP carrier delivery and receiving device, such that a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device. A customer somehow positioned inside of Casale’s building (10) would have no need of any carrier delivery and

receiving device. As in conventional fast food establishments, any customer permitted into Casale's building would simply communicate directly to the employee and the items would be transferred by hand, without need of the recited customer station, SP station, and carrier delivery and receiving device.

An interior customer station would destroy the disclosed benefits of Casale

Casale desires that the customer have their food at the drive-thru pickup window less than one minute after ordering (col. 6, lines 48-57). That is, a strong desire in Casale is that a customer receive their food as conveniently and as fast as possible. Requiring a customer to take additional time to enter the "fast food" establishment would destroy the ability of Casale to conveniently and quickly service customers, especially customers located in their cars. Hence, it would not have been obvious (and it is directly contrary to Casale's teaching) to have customers leave their auto, walk into the "fast food" establishment, place their order, and then wait for a nonhuman "device" to deliver their food item by a carrier. Furthermore, Casale's small building size only permits two order takers/cashiers to be working simultaneously, one for each walk-up/drive-up window (20, 22) (col. 8, lines 19-22). Even if it were somehow possible to modify Casale to deliver a food item by carrier to the customer (which it isn't), the modification at best would entail having the fast food item delivered directly to the customer while they remained in their auto located outside of the building (10).

Furthermore, as discussed in more detail hereinafter, even if it were somehow possible to modify Casale to deliver a food item by carrier, there is no teaching or suggestion that Casale's system would enable the carrier to deliver an item from the customer to a service provider at an



SP station. That is, the carrier in a modified Casale would only be able to deliver food one-way (i.e., to the customer). Thus, even if Casale's system were somehow able to be modified as alleged, all of the claimed features and relationships would still not be met.

Bustos does not disclose or suggest the recited "customer station"

The alleged customer station (hotel room 104) of Bustos cannot constitute the recited "customer station." Thus, even if it were somehow possible to include Casale's building (10) with Bustos' alleged customer station (which it isn't), a modified Casale would still lack the features of the recited invention. In Bustos a carrier is not enabled to be selectively moved with a transaction item from the customer at a customer carrier delivery and receiving device to a service provider at an SP carrier delivery and receiving device. That is, in Bustos a carrier with a transaction item is not enabled to be selectively moved from a customer station to an SP station. Bustos' system acts as an extended vending operation delivering products one-way from the vender to the customer. Thus, even if it were somehow possible to include Casale's small sized building (10) with Bustos' rather large pneumatic delivery system (101) (which as previously discussed it isn't), the combined references would still lack the recited features of the invention.

The described structure of Bustos is not intended to nor capable of transferring a canister with a transaction item from a customer station to an SP station. All of the described embodiments in Bustos disclose or suggest only moving a transaction item one-way from a loader (e.g., 57, 111) to a customer. Bustos does not disclose or suggest moving transaction items two-way. Furthermore, only a customer is disclosed as removing a product item (40) from a carrier (31). Furthermore, only a loader is disclosed as loading a product item (40) into a

carrier (31). Thus, Bustos does not disclose or suggest moving a canister with a transaction item from a customer station to an SP station. Hence, the teachings of Bustos do not provide basis for modifying Casale to include the recited features and relationships.

As previously discussed, in Bustos the system acts as an extended vending operation delivering products only one-way from the vender to the customer. In Bustos' system the tube (26) has a single loading end (32) and a single discharge end (33) (col. 9, lines 3-8). Payment is made electronically without the need for the carrier system (101) to deliver transaction items two-way via plural delivery and receiving devices.

Therefore, Bustos does not disclose or suggest that "a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device." It follows that the alleged customer station (hotel room 104) of Bustos does not constitute the recited "customer station." Thus, even if it were somehow possible to include Casale's building (10) with Bustos' alleged customer station, a modified Casale would still lack the recited features and relationships of the invention.

It is noted that in an exemplary embodiment of a system of the present invention, the system permits banking transaction items to be selectively moved two-way between the customer and the service provider. In contrast, neither Casale nor Bustos are directed to providing banking transactions. Casale is directed to a conventional fast food establishment. Bustos is directed to a food vending operation with electronic payment. Thus, neither Casale nor Bustos have any need or desire to provide two-way movement of transaction items.

Bustos does not disclose or suggest the recited “SP station”

It is respectfully submitted that Bustos also does not disclose an “SP station” enabled to be operated by a service provider providing a transaction. If Bustos does not disclose the recited “SP station”, then it follows that Bustos also does not disclose a recited customer station in “operative connection” with a recited SP station.

In Bustos a customer in a room (104) orders a menu item which is automatically charged to the customer’s room or account. The order is first communicated to an office (110) where billing equipment is located. Next the system is programmed to operate automated product selection and loading equipment (111) at the storage unit (102) (col. 14, lines 1-4). The storage unit (102) may be manually loaded (col. 14, lines 21-25). Therefore, Bustos requires both an office (110) and a loader (111) for providing a single transaction. However, the office and the loader are distant from each. Therefore, Bustos requires at least two distant “stations” for providing a single transaction. However, the claim recites that “the SP station is enabled to be operated by a service provider providing a transaction” and that “the SP station includes therein an SP carrier delivery and receiving device.” Thus, neither the office nor the loader constitutes an SP station as specifically recited. It follows that Bustos does not disclose an SP station enabled to be operated by a service provider providing a transaction in the manner recited.

At best, it is Bustos’ product storage area (102, 111) that provides an SP delivery “device.” However, the features of the product storage area (102, 111) do not permit it to constitute the recited “SP station.” As previously discussed, this “device” does not permit “receiving” of transaction items. Nor does this device permit “providing a transaction” by a

service provider at an SP station (billing equipment in office 110 is also required to provide a transaction). Thus, Bustos does not disclose or suggest an SP station as specifically recited.

Not obvious to insert the alleged customer station of Bustos into Casale

The rejections in the Action are respectfully asserted to be improper because they are based upon hindsight from Appellants' teachings. This is demonstrated by the Action's failure to provide any explanation as to how the alleged customer station (hotel room 104) in Bustos could have been inserted inside of Casale's small building (10) (about the size of two typical parking spaces joined end-to-end). Nor has the Action shown how such an insertion would have been obvious to one having ordinary skill in the art. As previously discussed, the building of Casale is too small in size to have included any customer station, especially a hotel room. Also, the lengthy pneumatic tube system and loader of Bustos, which would be required to be located in Casale's building, would further prevent (and teach away from) such an insertion.

The combined teachings of Casale and Bustos would still lack features of the recited invention

As previously discussed, neither Casale nor Bustos teach the recited features and relationships. Nor would it have been obvious to one having ordinary skill in the art to have modified Casale with the teachings of Bustos as alleged. Furthermore, even if it were somehow possible, inserting the teachings of Bustos into the Casale reference would still not have produced the claimed invention.

First, it would not have been structurally possible to have added Bustos' alleged customer station (room 104) to the inside of Casale's small building (10). Nor would it have been obvious to have added Bustos' lengthy pneumatic tube system and loader to the inside of Casale's small

building (10). Secondly, even if it were somehow possible to have added Bustos' room (104), tube system, and loader to the inside of Casale's small building (10), the combined system would still lack the recited features and relationships. That is, the combined system would still lack an SP carrier delivery and receiving device in operative connection with a customer carrier delivery and receiving device such that a carrier with a transaction item would be enabled to be selectively moved from a customer at the customer station to a service provider at the SP station.

Including the teachings of Bustos into Casale would have at best produced adding a receiving location for delivered food items (as taught by Bustos) to the exterior of Casale's building (10). However, the product receiving location would still not be positioned inside of Casale's building (10). Nor would a carrier be able to move from the product receiving location to an SP station inside of Casale's building (10). Thus, Bustos' teachings cannot overcome the deficiencies in Casale.

As previously discussed, Bustos does not disclose or suggest the recited features lacking in Casale. Nor would it have been obvious to have modified Casale with the teachings of Bustos. Therefore, it follows that it would not have been obvious to have combined Casale and Bustos as alleged to have produced Appellants' invention.

Neither Casale nor Bustos taken alone or in combination disclose or suggest the features and relationships that are specifically recited in claim 1. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable for

these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that the claims which depend from claim 1 are likewise allowable.

**Claim 38**

Claim 38 is an independent claim which is specifically directed to a system. The claim specifically recites a “service provider (SP) station” and a “customer station.” The claim recites that the SP station and a component of the customer station are positioned within the interior area of the same building. The claim further recites a customer station including a customer visual display in operative connection with an SP station CCTV camera; a customer station CCTV camera in operative connection with an SP station display; a customer station audio transmitting device and a customer station audio receiving device in operative connection with an SP station audio receiving device and an SP station audio transmitting device. The claim further recites a customer station pneumatic tube carrier delivery and receiving device in operative connection with an SP station pneumatic tube carrier delivery and receiving device, wherein a carrier is enabled to be selectively moved between the customer station and the SP station.

As previously discussed, the Action admits that Casale does not disclose an SP station and a customer station component positioned within the same building. However, Casale lacks many more of the recited features and relationships than the Action indicates. Thus, even if it were somehow possible for Casale to be combined with Bustos as alleged, the secondary reference would still not alleviate the deficiencies in Casale. It is respectfully submitted that Casale does not disclose or suggest:

- the SP station and a customer station component positioned within the same building. The Action admits that Casale does not disclose or suggest the recited features and relationships.
- the recited SP station components.
- the recited customer station components.
- “a customer pneumatic tube carrier delivery and receiving device” and a “SP pneumatic tube carrier delivery and receiving device.”
- the “customer pneumatic tube carrier delivery and receiving device in operative connection with the SP pneumatic tube carrier delivery and receiving device.”
- “a carrier is enabled to be selectively moved between the customer station and the SP station.”

The Action (page 6) admits that Casale does not disclose a customer station (and thus a customer station component) positioned inside of a building. The Action by inference also admits that Casale does not disclose an SP station and a customer station component positioned within the same building. The Appellants agree.

The Action alleges that Casale’s second level housing (14) constitutes an SP station. The Appellants disagree, as previously discussed. The alleged second level housing (14) does not meet the features and relationships of the recited SP station. The second level housing (14) lacks the recited visual display, camera, audio transmitting device, audio receiving device, and SP pneumatic tube carrier delivery and receiving device. Also, the cashier or person taking the order (e.g., the asserted service provider) is clearly one floor below in the base level housing (12) (col.

6, lines 29-33), not the second level housing (14). Therefore, the second level housing (14) does not meet the features of the recited SP station. Thus, the alleged SP station (14) cannot constitute the recited SP station.

As previously discussed, the Action is vague as to what particular feature in Casale constitutes the recited “customer station.” The Action merely states that the “customer station” is on the side at the lower ground level of the building (10). Nevertheless, Casale (and any alleged customer station) does not disclose a customer pneumatic tube carrier delivery and receiving device in operative connection with an SP pneumatic tube carrier delivery and receiving device in the manner recited. Furthermore, the alleged SP station (second level housing 14) lacks the recited visual display, camera, audio transmitting device, or audio receiving device. It follows that the alleged customer station does not disclose a display in operative connection with an SP camera; a camera in operative connection with an SP display; an audio transmitting device in operative connection with an SP audio transmitting device; an audio receiving device in operative connection with an SP audio receiving device; or a pneumatic tube carrier delivery and receiving device in operative connection with an SP pneumatic tube carrier delivery and receiving device in the manner recited. Therefore, the alleged customer station in Casale cannot constitute the recited customer station.

Furthermore, Casale’s remotely located menu and order display unit with its inner housing (52) also does not meet the features of the recited customer station. The inner housing (52) lacks a customer pneumatic tube carrier delivery and receiving device. As previously discussed, the customer simply drives to the pick-up window (22) to receive their previously



placed order. Since the food is picked up at the window, there is no need for any type of delivery means. Therefore, the inner housing (52) does not disclose a customer pneumatic tube carrier delivery and receiving device in operative connection with an SP pneumatic tube carrier delivery and receiving device in the manner recited. Therefore, the inner housing (52) cannot constitute the recited customer station.

The Action alleges that a carrier (conveyor trays 94; Figure 14) is able to be selectively moved with a transaction item (food products) between a customer pneumatic tube carrier delivery and receiving device and an SP pneumatic tube carrier delivery and receiving device. The Appellants disagree. Casale does not disclose a customer pneumatic tube carrier delivery and receiving device in operative connection with the SP pneumatic tube carrier delivery and receiving device, wherein a carrier is enabled to be selectively moved between the customer station and the SP station. First, since no customer is permitted inside of Casale's building (10), a customer is not capable of using the alleged carrier (94). Secondly, the alleged carrier (94) is not associated with a "pneumatic tube" system. The alleged carrier (94) is actually a part of a roller (92, 93) and belt (95) arrangement. Thus, Casale does not disclose a customer pneumatic tube carrier delivery and receiving device and an SP pneumatic tube carrier delivery and receiving device.

Casale also does not disclose the recited SP and customer station components. Casale does not disclose a system with two-way video, two-way audio, and pneumatic tube carrier communication between a customer and a service provider housed in the interior area of a building in the manner recited in the claim. Nothing in the cited art discloses having a customer

component positioned within the interior area of the same building as the service provider station. Such construction is totally contrary to prior uses of a customer station component and a service provider station.

The Action alleges that Bustos teaches having customer stations (104, 115-118; Figure 5D) inside a building. The Action further alleges that it would have been obvious “to apply the teachings of Bustos into Casale for constructing the customer stations as shown in fig. 5D inside the building” of Casale. The Appellants disagree.

As previously discussed, the arrangement of Casale is similar to known drive-thru fast food establishments where the customer first places their order at a menu location (52), then drives to the pick-up window (22) to pay for and receive their previously placed order. Casale desires that the customer always remain outside of the building. It would not have been obvious to have placed a customer station inside of Casale’s building (10) as alleged.

First, Casale’s building (10) is too small in size to support an interior customer station. The ground contact of the building (10) is small, “about the size of two typical parking spaces joined end-to-end” (col. 5, lines 42-46). The space needed for the building and its operation is designed as minimal. The arrangement and size of the building permits only two order takers/cashiers to be working simultaneously, one for each walk-up/drive-up window (20, 22) (col. 8, lines 19-22). Thus, there is simply no physical space available to include a “customer station” inside of Casale’s building (10). Therefore, it would not have been structurally possible to have added a “customer station” (alleged as a room 104 in Bustos) to the inside of Casale’s building (10).

Nor has the Action explained how the recited “customer station” could have been inserted inside of Casale’s building (10). Casale strongly desires to maintain the building of minimal size. The building (10) is readily set up and removed (Abstract), and transportable on a single truck bed in two parts (col. 5, lines 28-38). Thus, any attempt to dramatically increase the size of Casale’s building (10), which would occur with the addition of Bustos’ alleged customer station (room 104), would go directly against the implicit teaching of the Casale reference and would destroy the utility of the system shown in the reference. That is, the alleged modification to Casale would destroy the utility or operability of the Casale teaching. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Thus, the Office has not presented a *prima facie* showing of obviousness.

Bustos does not disclose or suggest the recited customer station components and the SP station components. Furthermore, even if a customer were somehow permitted into Casale’s building (10), that customer would have no need of a customer station having a visual display, camera, audio transmitting device, and audio receiving device. Nor would the customer have any need of a system having a customer pneumatic tube carrier delivery and receiving device in operative connection with an SP pneumatic tube carrier delivery and receiving device, such that a carrier is enabled to be selectively moved between the customer station and the SP station. As in conventional fast food establishments, any customer permitted into Casale’s building would

simply communicate directly to the employee and the items would be transferred by hand, without need of the recited customer station components and SP station components.

Secondly, Bustos does not disclose or suggest the recited customer station components and the SP station components. The Action alleges that Bustos teaches having a customer station (104) inside a building. In Bustos a customer in a room (104) may order a menu item which is automatically charged to a customer's room or account. The order is first communicated to an office (110) where billing equipment is located. Next the system is programmed to operate automated product selection and loading equipment (111) at the storage unit (102) (col. 14, lines 1-4). The storage unit (102) may be manually loaded (col. 14, lines 21-25). Therefore, Bustos requires both an office (110) and a loader (111) for providing a single transaction. However, the office and the loader are distant from each. Therefore, Bustos requires at least two "stations" for providing a single transaction. However, the claim recites that "the SP station is enabled to be operated by a service provider providing a transaction" and that "the SP station includes therein an SP carrier delivery and receiving device." Thus, neither the office nor the loader constitutes an SP station as specifically recited. It follows that Bustos does not disclose an SP station enabled to be operated by a service provider providing a transaction in the manner recited.

Nor does the alleged customer station (hotel room 104) in Bustos include the specifically recited customer station components (visual display, camera, audio transmitting device, and audio receiving device). It follows that Bustos does not disclose a customer station in the manner recited. Therefore, even if it were somehow possible to have added Bustos' room (alleged customer station 104) inside of Casale's small building (10), the combined system would still

lack a customer station having a visual display, camera, audio transmitting device, and audio receiving device.

Nor has the Action explained how the alleged customer station (hotel room 104) in Bustos could have been inserted inside of Casale's small building (10) (about the size of two typical parking spaces joined end-to-end). Nor would such an insertion have been obvious to one having ordinary skill in the art. As previously discussed, the building of Casale is too small in size to have included any customer station. The lengthy pneumatic tube system of Bustos further prevents (and teaches away from) such an insertion.

Casale does not have an interior customer station component for good reason. Customers are not permitted in the small building. Combining the teachings of Bustos into Casale would not have produced the claimed invention. First, it would not have been structurally possible to have added Bustos' alleged customer station (room 104) to the inside of Casale's small building (10). Secondly, Bustos' alleged customer station does not include a visual display, camera, audio transmitting device, and audio receiving device. Thirdly, even if it were somehow possible to have added Bustos' room (104) to the inside of Casale's small building (10), the combined system would still lack the recited features and relationships of the stations. Furthermore, as previously discussed, the combined system would still lack a customer pneumatic tube carrier delivery and receiving device in operative connection with an SP pneumatic tube carrier delivery and receiving device, such that a carrier is enabled to be selectively moved between the customer station and the SP station.

Including the teachings of Bustos into Casale, if possible, would have at best produced adding a customer product receiving location to the exterior of Casale's building (10). However, the product receiving location would still not have a customer component positioned inside of Casale's building (10). Nor would the product receiving location include a visual display, camera, audio transmitting device, and audio receiving device. Thus, Bustos does not overcome the deficiencies in Casale. Therefore, it follows that it would not have been obvious to have combined Casale and Bustos as alleged to have produced Appellants' invention.

Neither Casale nor Bustos taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It follows that the claims which depend from claim 38 are likewise allowable.

#### **Claim 41**

Claim 41 is an independent claim which recites exemplary features of Appellants' system. The claim recites a system including a customer station and a building. The claim further recites that the customer station includes at least one component of a customer visual display; a customer CCTV camera; a customer audio transmitting device; a customer audio receiving device; and a customer carrier delivery and receiving device. The claim further recites that the customer station includes a frame in supporting connection with an interior wall of the

building. The claim further recites that the frame extends in an opening of the interior wall, and that a customer component is in supporting connection with the frame.

An advantage of an exemplary embodiment of the invention is that the customer station can be installed in an interior of a building, such as in supporting connection with a door frame. The construction provides a customer station that occupies minimal floor space and is easy to install and service.

The Action is silent as to what element constitutes the alleged frame in the rejection. Thus, Appellants have been given the undue burden of having to speculate as what allegedly constitutes the recited “frame.” It is respectfully submitted that neither Casale nor Bustos disclose a frame in the manner recited.

The Action is silent as to what element constitutes the alleged “frame” in Casale. A previous Action alleged that Casale’s drive-in window inherently had a “frame.” The current Action indicates that “the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on a frame.” The current Action also alleges that McClure’s customer station has cover (36) mounted on a “frame.”

Apparently, the Action by inference admits that the combination of Casale and Bustos fails to teach a “frame” and relies on McClure for such teaching (Action page 3, lines 3-8). However, claim 41 (which includes recitation of a frame) was only rejected over Casale in view of Bustos. That is, the rejection of the claim does not include McClure.

Casale does not disclose or suggest a frame as recited. Furthermore, even if it were possible for the drive-in window (22) to inherently have a frame, there is no indication in Casale

that the drive-in window frame is in supporting connection with an interior wall in an interior area of a building. At best any drive-in window "frame" would be arranged in an exterior wall of Casale's building (10). Nor is there any indication in Casale that a recited customer station "component is in supporting connection with the frame." Where does Casale disclose a recited customer station component (visual display; CCTV camera; audio transmitting device; audio receiving device; or a carrier delivery and receiving device) positioned in supporting connection with the alleged window frame? Casale does not disclose that a customer station "component is in supporting connection with the frame" in the manner recited.

Casale's speaker/microphone (58) and display (62) are located at Casale's inner housing (52). However, Casale's inner housing (52) is separate and distant from the alleged frame associated with the drive-in window. The inner housing (52) is part of a menu and display unit disposed on the lot containing the fast food building (10), preferably in the drive-up lanes (16, 18). The inner housing (52) is disposed at a distance from the pick-up window (22), otherwise the speaker/microphone (58) and display (62) would not be needed. Therefore, neither Casale's speaker/microphone (58) nor display (62) can constitute a customer station component "in supporting connection with the frame."

Furthermore, even if it were somehow possible to modify Casale so that a customer station component was positioned in supporting connection with the alleged window frame, it would then not be possible for a customer to use the window (22) as a pick-up window. The addition of a component to the alleged window frame would prevent use of the window in the



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manner described in the Casale reference. Such a modification would destroy the operability of the Casale system.

A reference teaching away from the recited invention does not support *prima facie* obviousness. It is improper to reconstruct the recited invention from the disclosure of the Appellants. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine 5 USPQ2d 1598-99 (Fed. Cir. 1988)*. Thus, the Office has not presented a *prima facie* showing of obviousness.

As previously discussed, the building (10) of Casale is too small in size to have included customer station features, especially a customer station frame extending in an opening of an interior wall, and a customer station component in supporting connection with the frame.

Furthermore, support for the building (10) of Casale is provided by four steel columns (29). The walls of the base level (12) appear to consist of panes of glass (24). Thus, the building (10) of Casale does not appear to have any interior walls that would permit a frame to extend in an opening therein and be in supporting connection therewith. Accordingly it would not be possible to have a customer station component in supporting connection with such a frame.

Bustos does not disclose or suggest a frame as recited. None of Bustos' embodiments disclose or suggest a customer component in supporting connection with a frame which extends in an opening of an interior wall of a building. Nor does Bustos disclose or suggest that the customer component includes at least one of a customer visual display; a customer CCTV

camera; a customer audio transmitting device; a customer audio receiving device; and a customer carrier delivery and receiving device.

In Bustos' Figure 1 the dispensing unit (20) and its related panel (22) do not comprise a frame in the manner recited. Nevertheless, even if it were somehow possible for the dispensing unit (20) to have included a frame, the frame would still not be extending in an opening of an interior wall of a building. This is because the dispensing unit (20) is not located in the building (15). Bustos also does not disclose that a customer station "component is in supporting connection with the frame" in the manner recited.

In Bustos' Figure 5D a guest is able to select an item from a menu displayed on a screen (106) of a cable television set (107) in a hotel room (104) (col. 13, lines 63-65). The television set (107) does not comprise a frame. Nor does the television set (107) comprise a frame extending in an opening of an interior wall of a building. Nor is there disclosed a customer station component in supporting connection with a frame in the manner recited. Thus, Bustos cannot overcome the deficiencies in Casale. Therefore, it follows that it would not have been obvious to have combined Casale and Bustos as alleged to have produced Appellants' claimed invention.

Neither Casale nor Bustos taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable for

these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It follows that the claims which depend from claim 41 are likewise allowable.

**Claim 47**

Claim 47 is an independent claim which is specifically directed to a transaction system. The claim specifically recites an “SP station” and a “customer station.” The claim further recites that “the SP station includes an SP communication device” and “the customer station includes a customer communication device.” The claim further recites that “the customer communication device is in operative connection with the SP communication device” enabling communication between a customer at the customer station and a service provider at the SP station. The claim further recites a “delivery device” and that the “delivery device is adapted to hold a transaction item” deposited in an inner volume thereof. The claim further recites that “the delivery device is movable to deliver a deposited transaction item from either of the SP or customer stations to the other respective SP or customer station.” The claim further recites a “building” and that both “the SP station and the customer station are positioned inside of the building.”

The Action admits that in Casale “the customer is on the side of the building but is not inside the building as claimed.” Therefore, since there is no customer inside the building, then there can be no customer station inside the building. It follows that the Action admits that Casale does not disclose an SP station and a customer station positioned inside of the same building.

The Action alleges that Casale discloses an SP station (second level housing 14) and a customer station (i.e., on the side at lower ground level of the building 10). However, there is no indication in Casale that the alleged customer station is in communication with the alleged SP

station (14). Casale does not disclose or suggest that an outside customer (located at either the inner housing (52) menu, or the walk-up window (20), or the pick-up window (22)) is able to communicate with an employee located at the alleged SP station (in the building at the upper second level housing 14) using communication devices. Therefore, Casale does not disclose the recited “customer communication device is in operative connection with the SP communication device enabling communication between a customer at the customer station and a service provider at the SP station.”

Additionally, Casale does not disclose that a “delivery device is movable to deliver a deposited transaction item from either of the SP or customer stations to the other respective SP or customer station.” There is no indication in Casale of a delivery device capable of delivering a transaction item from the alleged customer station (i.e., on the side at lower ground level of the building 10) to the alleged SP station (14) on the upper floor of the building.

Nor is there any indication in Casale that the alleged SP station (14) is capable of receiving a delivered transaction item from the alleged customer station. The Action states that the food products constitute the alleged transaction item. However, it is respectfully submitted that the alleged transaction item (food product) is not capable of being moved from the alleged customer station (i.e., on the side at lower ground level of the building 10) up to the alleged SP station (14) by using the alleged carrier (tray 94). First, since there is no customer inside the building, as admitted by the Office, then there also is no customer station inside the building. Thus, the customer is not capable of using the alleged carrier (94). Furthermore, to enable a customer (located outside) in Casale to move a food product to the alleged SP station (upper

portion 14) would require a completely different structure from that disclosed and desired in the Casale reference. Secondly, even if it were somehow possible for a customer to use the alleged carrier (94), the hinged trays (94) point downward during their upward trip (col. 8, lines 14-16; Figure 14) which would make it impossible to hold a food product for movement to the second level. Further, there would be no reason in Casale to move food items to the second level. Additionally, the alleged carrier (94) in Casale is not capable of holding a transaction item in an "inner volume" thereof during a delivery in the manner recited. Thus, the alleged carrier (94) is not capable of carrying or moving a food product to the alleged SP station (14) as alleged. Hence, the alleged carrier (94) cannot constitute the recited "delivery device." Thus, Casale does not disclose that a "delivery device is movable to deliver a deposited transaction item from either of the SP or customer stations to the other respective SP or customer station" in the manner recited.

Additionally, Casale does not disclose having the recited SP station and the recited customer station in the same building. The Action admits that Casale does not disclose an SP station and a customer station positioned inside of the same building. In Casale it is the menu and display unit inner housing (52) which is actually used by a customer. The inner housing (52) is separate from the alleged customer station (i.e., on the side at lower ground level of the building 10) and the alleged SP station (second level housing 14). The inner housing (52) is part of a menu and display unit disposed on the lot containing the fast food building (10), preferably in the drive-up lanes (16, 18). The inner housing (52) is disposed at a distance from the pick-up window (22). The arrangement of Casale is similar to known drive-thru fast food establishments

where the customer first places their order at a menu location, then drives to the pick-up window (22) to pay for and receive their previously placed order. Therefore, the transaction occurs by hand at the pick-up window (22). There is no delivery device at the inner housing (52). Since the food is picked up at the window, there is no need for such a delivery device. Therefore, Casale does not disclose that “the SP station and the customer station are positioned inside of the building.”

Bustos does not overcome the deficiencies in Casale. The claim recites that a transaction item is enabled to be deposited into the inner volume at the SP station. Bustos’ items are deposited at the item loader (111, 123). However, Bustos does not disclose or suggest that a customer at the alleged customer station (hotel room 104) is able to communicate with an employee (service provider) located at the item loader (111, 123) using any communication devices. Nor is an employee (service provider) located at the item loader able to communicate with a customer at the alleged customer station (hotel room 104). Therefore, Bustos does not disclose the recited “customer communication device is in operative connection with the SP communication device enabling communication between a customer at the customer station and a service provider at the SP station.”

Additionally, Bustos does not disclose that a “delivery device is movable to deliver a deposited transaction item from either of the SP or customer stations to the other respective SP or customer station.” In Bustos the system acts as an extended vending operation delivering products only one-way from the vender to the customer. There is no disclosure or suggestion in

Bustos that a transaction item is capable of being delivered from the alleged customer station (hotel room 104) to the loader (111, 123).

Nor is there any indication in Bustos that the loader (111, 123) or product storage building (15, 102) has the capability to receive or store a delivered transaction item from the alleged customer station.

Thus, Bustos does not overcome the deficiencies in Casale. Therefore, it follows that it would not have been obvious to have combined Casale and Bustos as alleged to have produced Appellants' claimed invention.

Combining the teachings of Bustos into Casale would not have produced the claimed invention. First, as previously discussed, it would not have been structurally possible nor desirable to have added Bustos' alleged customer station (room 104) to the inside of Casale's small building (10). Any attempt to dramatically increase the size of Casale's building (10), which would result from the addition of Bustos' alleged customer station (room 104), would go directly against the teaching of the Casale reference and would destroy the advantages of the system shown in the reference. Thus, the alleged modification to Casale would destroy the utility or operability of the Casale teaching. Secondly, Bustos does not disclose or suggest the recited communication devices enabling communication between a customer at the customer station and a service provider at the SP station. Thus, Bustos is unable to modify Casale to include the recited communication devices. Thirdly, Bustos does not disclose that a "delivery device is movable to deliver a deposited transaction item from either of the SP or customer stations to the other respective SP or customer station." Thus, Bustos is unable to modify Casale to include the

recited delivery device. Therefore, even if it were somehow possible to have added Bustos' alleged customer station (room 104) to the inside of Casale's small building (10), the combined system would still lack the recited features and relationships. Including the teachings of Bustos into Casale would have at best, if even possible, produced adding a customer's product receiving location exterior of Casale's building (10). However, the product receiving location would still not be positioned inside of Casale's building (10). Nor would the product receiving location include a communication device enabling communication between a customer and a service provider. Nor would the product receiving location be associated with a delivery device capable of delivering a transaction item from the location to a service provider station. Bustos cannot overcome the deficiencies in the teachings of Casale. Therefore, it follows that it would not have been obvious to have combined Casale and Bustos as alleged to have produced Appellants' claimed invention. Thus, the Office has not presented a *prima facie* showing of obviousness.

Neither Casale nor Bustos taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' recited invention, it is respectfully submitted that the claim is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.



**The Dependent Claims Are Not Obvious Over  
Casale in view of Bustos**

Each of the dependent claims 2-4, 12-13, 18-19, 24-27, 37, 39-40, and 42 depend directly or indirectly from an independent claim, and it is asserted that these dependent claims are allowable on the same basis. Furthermore, each of the dependent claims additionally recite specific features and relationships that patentably distinguish the claimed invention over the applied art. The applied references do not disclose or suggest the recited features and relationships of the dependent claims. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellants' invention. The Action has failed to establish that the features and relationships recited in the claims are shown in the applied references. Neither Casale nor Bustos taken alone or in combination disclose or suggest the features and relationships recited in the dependent claims. No prima facie obviousness has been established and the claims are further allowable on this basis. Thus, it is respectfully submitted that the dependent claims are further allowable.

**Claim 2**

Claim 2 depends from claim 38 and further recites that "the customer station is positioned within the interior area of the building." Thus, the customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device, and customer pneumatic tube carrier delivery and receiving device are each positioned inside the same building as the SP station. The recited SP station includes an SP visual display, SP CCTV camera, SP audio transmitting device, SP audio receiving device, and SP pneumatic tube carrier delivery and

receiving device. Neither Casale nor Bustos taken alone or in combination disclose or suggest each of these customer station components positioned inside the same building as the SP station components. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

### **Claim 3**

Claim 3 depends from claim 2 and further recites that "a plurality of customer stations are positioned within the interior area of the building." Neither Casale nor Bustos taken alone or in combination disclose or suggest a customer station positioned inside the same building as an SP station, in the manner recited. It follows that neither Casale nor Bustos taken alone or in combination disclose or suggest a plurality of customer stations positioned inside the same building as an SP station. Neither Casale nor Bustos disclose a customer station positioned inside the same building as an SP station, where the customer station includes a customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device, and customer pneumatic tube carrier delivery and receiving device. Neither Casale nor Bustos disclose an SP station positioned inside the same building as a customer station, where the SP station includes an SP visual display, SP CCTV camera, SP audio transmitting device, SP audio receiving device, and SP pneumatic tube carrier delivery and receiving device. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully

submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

**Claim 4**

Claim 4 depends from claim 38 and further recites that "the customer station comprises a frame." The frame is in supporting connection with the interior wall and extends in the wall opening. Furthermore, at least one of the customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device, or customer carrier device is in supporting connection with the frame.

As previously discussed, the Action by inference admits that the combination of Casale and Bustos fails to teach a "frame" and relies on McClure for such teaching (Action page 3, lines 3-8). However, claim 4 (which includes recitation to a frame) was only rejected over Casale in view of Bustos. That is, the rejection of the claim does not include McClure.

Neither Casale nor Bustos taken alone or in combination disclose or suggest a frame in the manner recited. Neither reference teaches a frame in supporting connection with an interior wall. It follows that neither Casale nor Bustos taken alone or in combination disclose or suggest a frame extending in an opening of an interior wall of a building. It further follows that neither Casale nor Bustos taken alone or in combination disclose or suggest a customer station component in supporting connection with the frame.

As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would

not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

### **Claim 12**

Claim 12 depends from claim 38 and further recites that "the system comprises a plurality of customer stations." Furthermore, the SP station is in operative connection with a communication selector device. Additionally, the video and audio connection between the SP station and one of the customer stations is responsive to an input to the communication selector device.

Neither Casale nor Bustos taken alone or in combination disclose or suggest a customer station in the manner recited. It follows that neither Casale nor Bustos taken alone or in combination disclose or suggest a plurality of customer stations in the manner recited. Neither Casale nor Bustos disclose a customer station component positioned inside the same building as an SP station, where the customer station includes a customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device, and customer pneumatic tube carrier delivery and receiving device. Neither Casale nor Bustos disclose an SP station positioned inside the same building as a customer station component, where the SP station includes an SP visual display, SP CCTV camera, SP audio transmitting device, SP audio receiving device, and SP pneumatic tube carrier delivery and receiving device.

In further regard to claim 12 the Action alleges that Casale discloses plural customer stations (col. 2, lines 11 and 36), and the SP station in connection with a communication selector device (menu and display unit; col. 6, lines 48-57). However, the cited sections are not pertinent

to the recited claim language. For example, Casale does not disclose a customer station component positioned inside the same building as an SP station. Even the Action admits that the customer, and hence a customer station component, “is not inside the building as claimed.”

Additionally, the menu and display unit (the alleged communication selector device) is associated with the cashier taking the order in the lower level housing (12) (col. 6, lines 30-36). However, the Action already limited the alleged SP station to the upper level housing (14). Thus, the alleged communication selector device would be associated with the lower level housing (12), not the alleged SP station (upper level housing 14). Thus, Casale does not disclose or suggest that the video and audio connection between the SP station and one of the customer stations is responsive to an input to the communication selector device.

Also, there is no indication in either Casale or Bustos that an SP station is in operative connection with a communication selector device. There is no indication that a video and audio connection between an SP station and one of plural customer stations is responsive to an input to a communication selector device.

As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants’ recited invention.

### **Claim 13**

Claim 13 depends from claim 12 and further recites that “at least one customer station comprises a sensor.” The sensor is operative to sense a person positioned adjacent the customer

station. The SP station includes an indicator in operative connection with the sensor. An indication is given at the SP station of the presence of the person adjacent the customer station.

Neither Casale nor Bustos taken alone or in combination disclose or suggest a customer station sensor and an SP station indicator in the manner recited.

In regard to claim 13 the Action alleges that Casale discloses a customer station sensor (camera) and an indicator (order received). The Appellants disagree.

The claim recites that the SP station includes the indicator. As previously discussed, the order in Casale is received by a cashier in the lower level housing (12) (col. 6, lines 30-36), not the alleged SP station (upper level housing 14). Thus, Casale does not disclose or suggest that the SP station includes the indicator.

Furthermore, the claim recites that the indicator is in operative connection with the sensor. It is not seen how there is any operative connection between Casale's alleged customer station sensor (camera) and the alleged indicator (order received). Thus, Casale does not disclose or suggest the recited features and relationships.

Also, there is no indication that Bustos discloses or suggests the features and relationships lacking in Casale. Bustos does not disclose or suggest a customer station comprising a sensor, or an SP station including an indicator. Thus, Bustos cannot overcome the deficiencies in Casale. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

### **Claim 18**

Claim 18 depends from claim 2 and further recites that “the building includes a secure room, and wherein the SP station is housed in the secure room, and wherein the customer station is disposed outside of the secure room.” As previously discussed, neither Casale nor Bustos taken alone or in combination disclose or suggest a customer station positioned inside the same building as an SP station, in the manner recited. Furthermore, neither Casale nor Bustos taken alone or in combination disclose or suggest that the building includes a secure room. Furthermore, neither Casale nor Bustos taken alone or in combination disclose or suggest that the SP station is housed in the secure room and the customer station is disposed outside of the secure room.

The Action (page 8, lines 11-12) alleges that McClure’s “service station is a secure room (the teller station (18) is inside the bank which is a secure room).” Thus, it is unclear whether the Action relies on McClure for the rejection of claim 18. Nevertheless, claim 18 (which includes recitation to a secure room) was only rejected over Casale in view of Bustos. That is, the rejection of the claim does not include McClure.

The Action (page 4, lines 18-19) also alleges that Kaehler teaches a secure room. Thus, it is unclear whether the Action relies on Kaehler for the rejection of claim 18. Nevertheless, claim 18 (which includes recitation to a secure room) was only rejected over Casale in view of Bustos. That is, the rejection of the claim does not include Kaehler.

Neither reference (including McClure or Kaehler) discloses nor suggests a “secure room” in the manner recited. The claim recites that both a customer station and an SP station are positioned inside the same building, where the SP station is housed in a secure room, and where

the customer station is disposed outside of the secure room. Neither reference teaches a customer station (10) positioned inside the same building as the SP station, yet outside of the secure room.

Neither Casale nor Bustos taken alone or in combination disclose or suggest a secure room arrangement in the manner recited. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

#### **Claim 19**

Claim 19 depends from claim 18 and further recites that "the system further comprises a plurality of customer stations in the building, wherein each of the customer stations being in operative connection with the SP station." Neither Casale nor Bustos taken alone or in combination disclose or suggest a plurality of customer stations positioned inside the same building as an SP station. Furthermore, neither reference discloses that a plurality of interior customer stations are in operative connection with the same interior SP station.

Furthermore, neither Casale nor Bustos disclose a customer station including a customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device, and customer pneumatic tube carrier delivery and receiving device. Neither Casale nor Bustos disclose an SP station including an SP visual display, SP CCTV camera, SP audio transmitting device, SP audio receiving device, and SP pneumatic tube carrier delivery and receiving device.



Neither Casale nor Bustos taken alone or in combination disclose or suggest a plurality of customer stations in the manner recited. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

**Claim 24**

Claim 24 depends from claim 38 and further recites that "the system further comprises a plurality of customer stations in operative connection with the SP station." Each customer station includes a device actuatable by a customer. The system further includes a queuing device at the SP station. The queuing device is in operative connection with each customer actuatable device.

The Action is silent as to the claimed "device actuatable by a customer" and "a queuing device." There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention. The Action is also silent as to how a device actuatable and a queuing device could be implemented into the combination of references to produce Appellants' invention. Thus, Appellants have been left to speculate as to how a device actuatable by a customer and a queuing device not shown in any cited art could be implemented in the applied references. Thus, the Action procedurally fails to establish a prima facie case of obviousness.

Neither Casale nor Bustos taken alone or in combination disclose or suggest a plurality of customer stations, a device actuatable, and a queuing device in the manner recited. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted

that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

**Claim 25**

Claim 25 depends from claim 24 and further recites that "the SP station further includes a communication selector unit." The selector unit is in operative connection with the queuing device.

Neither Casale nor Bustos taken alone or in combination disclose or suggest a communication selector unit in operative connection with a queuing device in the manner recited.

The Action (page 7, lines 5-6) alleges that in Casale the alleged SP station is in connection with a communication selector device (menu and display unit; col. 6, lines 48-57). However, the cited sections are not pertinent to the recited claim language. For example, Casale does not disclose a customer station component positioned inside the same building as an SP station. Even the Action admits that the customer, and hence a customer station component, "is not inside the building as claimed."

Additionally, the menu and display unit (the alleged communication selector unit) is associated with the cashier taking the order in the lower level housing (12) (col. 6, lines 30-36). However, the Action already limited the alleged SP station to the upper level housing (14). Thus, the alleged communication selector unit would be associated with the lower level housing (12), not the alleged SP station (upper level housing 14). Thus, Casale does not disclose or suggest the recited communication selector unit.

Furthermore, Casale does not disclose or suggest a communication selector unit in operative connection with a queuing device. Therefore, neither Casale nor Bustos taken alone or in combination disclose or suggest the recited invention.

Also, there is no indication that either reference discloses or suggests that an SP station includes a communication selector unit in the manner recited. There is also no indication that a communication selector unit in operative connection with a queuing device.

Furthermore, the Action is silent as to the claimed “queuing device.” There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants’ claimed invention. The Action is also silent as to how a queuing device could be implemented into the combination of references to produce Appellants’ claimed invention. Thus, Appellants have been left to speculate as to how a queuing device not shown in the cited art could be implemented in the applied references. Thus, the Action procedurally fails to establish a prima facie case of obviousness.

As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants’ recited invention.

#### **Claim 26**

Claim 26 depends from claim 25 (which depends from claim 24). Each customer station includes a device actuable by a customer (claim 24). Claim 26 further recites that “the customer actuable device comprises a customer presence sensor.”

Neither Casale nor Bustos taken alone or in combination disclose or suggest a customer actuatable device or a customer presence sensor in the manner recited.

The Action (page 7, line 8) alleges that Casale discloses a customer station “sensor” (camera). The Appellants disagree.

As previously discussed, the Action is silent as to the claimed “customer actuatable device.” Thus, the Action procedurally fails to establish a prima facie case of obviousness.

Furthermore, it is not seen where in Casale that a customer actuatable device (actuatable by a customer) includes a customer presence sensor. It is not seen where a device (actuatable by a customer) in Casale includes the alleged sensor (camera). Thus, Casale does not disclose or suggest the recited features and relationships.

Also, there is no indication that Bustos discloses or suggests the features and relationships lacking in Casale. Bustos does not disclose or suggest a customer actuatable device or a customer presence sensor in the manner recited. Thus, Bustos cannot overcome the deficiencies in Casale. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants’ recited invention.

#### **Claim 27**

Claim 27 depends from claim 26 and further recites a relationship involving the queuing device, a customer station, SP station, customer presence sensor, and a customer.

Neither Casale nor Bustos taken alone or in combination disclose or suggest the relationship in the manner recited.

As previously discussed, the Action is silent as to the claimed “queuing device.” There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants’ recited invention. The Action is also silent as to how a queuing device could be implemented into the combination of references to produce Appellants’ invention. Thus, Appellants have been left to speculate as to how a queuing device not shown in the cited art could be implemented in the applied references. Thus, the Action procedurally fails to establish a prima facie case of obviousness.

As previously discussed, neither Casale nor Bustos taken alone or in combination disclose or suggest a customer presence sensor in the manner recited. The Action (page 7, line 8) alleges that Casale discloses a customer station “sensor” (camera). The Appellants disagree. It is not seen anywhere in Casale that a customer actuatable device (actuatable by a customer) (claim 26) includes a customer presence sensor. It is not seen where a device (actuatable by a customer) in Casale includes the alleged sensor (camera). Thus, Casale does not disclose or suggest the recited features and relationships.

Also, there is no indication that Bustos discloses or suggests the features and relationships lacking in Casale. Bustos does not disclose or suggest a customer queuing device or a customer presence sensor in the manner recited. Thus, Bustos cannot overcome the deficiencies in Casale. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants’ recited invention.

### **Claim 37**

Claim 37 depends from claim 28 and recites that “the transaction component is either a visual display, a customer CCTV camera, a customer audio transmitting device, a customer audio receiving device or a customer carrier device.”

Claim 28 relates to positioning a frame in an interior wall opening in supporting connection with the interior wall, and positioning at least one transaction component in supporting connection with the frame. Claim 37 further recites a specific transaction component.

As previously discussed, neither Casale nor Bustos taken alone or in combination disclose or suggest positioning a frame in supporting connection with an interior wall in the manner recited. The Action actually relies on McClure to allegedly teach a frame. However, McClure is not included in the rejection. It follows that neither reference discloses nor suggests positioning at least one transaction component in supporting connection with the frame. It further follows that neither reference discloses nor suggests that the transaction component is either a visual display, a customer camera, a customer audio transmitting device, a customer audio receiving device, or a customer carrier device. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants’ recited invention.

### **Claim 39**

Claim 39 depends from claim 38 and further recites that “a plurality of customer pneumatic tube carrier delivery and receiving devices are positioned within the interior area of the building.”

Neither Casale nor Bustos taken alone or in combination disclose or suggest a plurality of customer pneumatic tube carrier delivery and receiving devices positioned within the interior area of a building in the manner recited.

The Action (page 8, line3) actually relies on McClure to allegedly teach a pneumatic tube with carrier (51). However, McClure is not included in the rejection.

Claim 38 indicates that a customer station includes a customer pneumatic tube carrier delivery and receiving device. Claim 39 further recites that a plurality of customer pneumatic tube carrier delivery and receiving devices are positioned within the interior area of a building. However, none of the references teach a customer pneumatic tube carrier delivery and receiving device positioned within the interior area of a building. It follows that none of the references disclose a plurality of customer pneumatic tube carrier delivery and receiving devices positioned within the interior area of a building. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

#### **Claim 40**

Claim 40 depends from claim 39 and further recites that "a plurality of customer stations are positioned within the interior area of the building." The claim further recites that each customer station includes components in operative connection with the same interior SP station. The claim further recites that each customer station includes a customer pneumatic tube carrier delivery and receiving device, wherein a carrier is enabled to be selectively moved between the customer station and the SP station.

As previously discussed, neither Casale nor Bustos taken alone or in combination disclose or suggest a customer station positioned inside the same building as an SP station, in the manner recited. It follows that neither Casale nor Bustos taken alone or in combination disclose or suggest a plurality of customer stations positioned inside the same building as an SP station. Nor does either reference disclose a plurality of customer stations positioned inside the same building as an SP station, where each customer station includes a customer visual display, customer camera, customer audio transmitting device, customer audio receiving device, and customer pneumatic tube carrier delivery and receiving device in operative connection with the SP station. Nor does either reference disclose an SP station positioned inside the same building as a plurality of customer stations, where the SP station includes an SP visual display, SP camera, SP audio transmitting device, SP audio receiving device, and SP pneumatic tube carrier delivery and receiving device. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants' recited invention.

#### **Claim 42**

Claim 42 depends from claim 41 and further recites that the system comprises a plurality of customer stations, wherein each customer station includes a frame in supporting connection with an interior wall of the building, wherein each customer station includes at least one component of a customer visual display, a customer CCTV camera, a customer audio transmitting device, a customer audio receiving device, and a customer carrier delivery and



receiving device, and wherein the at least one component of each customer station is in supporting connection with the customer station frame.

Claim 41 recites that a customer station includes a frame in supporting connection with an interior wall of the building. Claim 41 further recites that the customer station frame extends in an opening of the interior wall, and that a customer component is in supporting connection with the frame. Claim 42 additionally recites a plurality of customer stations, and that each customer station includes a frame in supporting connection with an interior wall of the building. Claim 42 additionally recites that a component of each customer station is in supporting connection with that station's frame.

As previously discussed, neither Casale nor Bustos taken alone or in combination disclose or suggest a frame in supporting connection with an interior wall and extending in an opening of the interior wall in the manner recited. That is, neither reference discloses a frame in the manner recited. It follows that neither reference taken alone or in combination discloses or suggests positioning at least one customer station component in supporting connection with a frame. It further follows that neither reference taken alone or in combination discloses or suggests that the customer station component is either a visual display, a customer camera, a customer audio transmitting device, a customer audio receiving device, or a customer carrier delivery and receiving device. It further follows that neither reference taken alone or in combination discloses or suggests a plurality of customer stations, with each customer station including a frame in supporting connection with an interior wall of the building, and a component of each customer station in supporting connection with that station's frame.

The Action is silent as to what element constitutes the alleged frame in the rejection. Thus, Appellants have been given the undue burden of having to speculate as what constitutes the recited “frame.” Thus, Appellants have been left to speculate as to how a frame as recited could be implemented in the applied references. Thus, the Action procedurally fails to establish a prima facie case of obviousness. It is respectfully submitted that neither Casale nor Bustos disclose a frame in the manner recited. There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants’ recited invention. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale and Bustos to have produced Appellants’ recited invention.

**The Pending Claims Are Not Obvious Over  
Casale in view of Bustos and McClure**

Claims 5-11, 14-16, 20-23, 28-36, and 43-46 were rejected under 35 U.S.C. § 103(a) as obvious over Casale in view of Bustos and McClure. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants’ claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants’ invention. The features recited in Appellants’ claims patentably distinguish over the applied references.

Appellants hereinafter show that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. Furthermore, even if it were somehow possible for the references to have disclosed

certain features as alleged, it would still not have been obvious to have combined the references as alleged. Additionally, even if it were somehow possible for the references to be combined as alleged, the combined references would still not have produced Appellants' claimed invention.

The Action admits that with regard to Appellants' claimed customer station construction "the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame and movable to enable access the opening in supporting to connect with the wall, a door frame, at least one hinge, a sub-frame, a shelf, at least one storage location as specified in claims."

The Action (page 8) further alleges that McClure teaches "service banking equipment (figs. 1-5) having a customer station (10), the service station (18) and a pneumatic tube which carrier (51) that moves the capsule (40)." The customer station (10) is alleged to have "a cover (36), the door carries the capsule, mounted on the frame to enable access to the opening (26')." The Action further alleges that "a door frame (wherein the door (36) is connect to), one hinge, and a subframe are inherent in the art (fig. 1)." The Action further alleges that "the cover includes a generally horizontal extending shelf wherein the door (36) is open in position (36') the customer is enable to conduct writing or other activities on said shelf." The Action further alleges "at least one storage (a hollow cartridge), and switching device in operative connection with the service station (46), wherein the service station is a secure room (the teller station (18) is inside the bank which is a secure room)." The Action (page 3, lines 3-6) also alleges that "all mechanism elements" are "taught by McClure."

The Action further alleges that it would have been obvious "to modify the teachings of McClure into the customer station of the combination of Casale and Bustos in the same

arrangement as claimed for the same purpose of serving the customer at the remote location in order to reduce time, and improve the productivity of servicing person by serving more than one customer at the time.” The Appellants disagree, as discussed in more detail hereinafter.

**The Independent Claims Are Not Obvious Over  
Casale in view of Bustos and McClure**

The rejected claims include the independent claims 28, 43, and 45. It is respectfully submitted that these claims are allowable over Casale in view of Bustos and McClure.

**Claim 28**

Claim 28 is an independent claim which recites exemplary features of Appellants’ transaction system. The claimed invention relates to a transaction system including a customer station. The customer station is produced by a particular method. The method includes the steps of providing an interior building wall including a wall opening, and positioning a frame in the wall opening in supporting connection with the wall. The method further includes positioning a transaction component in supporting connection with the frame. The method further includes mounting a cover, having a component opening, in supporting connection with the wall in overlying relation of the wall opening.

An advantage of an exemplary embodiment of the invention is that the customer station can be installed in an interior of a building, by supporting the transaction components on a frame that bounds an opening such as a door frame. The construction provides a customer station that occupies minimal floor space and is easy to install and service.

The Action admits that Casale does not disclose an SP station and a customer station positioned inside of the same building. The Action (page 7, last paragraph) also admits that “the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame and movable to enable access the opening in supporting to connect with the wall, a door frame, one hinge, a sub-frame, shelf, one storage location as specified in claims.” The Action (page 7, last paragraph) admits that the combination of Casale and Bustos fails to particularly disclose all of the recited features and relationships of claim 28.

The Action alleges that McClure teaches a customer station (10), a service station (18), a cover (36) mounted on the frame to enable access to the opening (26') (col. 4, lines 24-34), and a door frame with a door (36) connected. The Appellants disagree. McClure does not teach the recited features, relationships, and steps.

McClure does not disclose a customer station having an interior building wall

There is no indication that the alleged customer station in McClure includes “an interior building wall including a wall opening therethrough.”

McClure is specifically directed to “the servicing of bank customers at a customer service-facility outside the bank” (col. 1, lines 14-22). McClure explicitly states that “General features of this invention comprise an exterior or customer station 10” and “an interior or bank station 18 desirably located within the bank” (col. 3, lines 31-36). McClure further indicates use of a “parking lot television scanner 100 by which an operator or teller on duty can become aware of a busy period” (col. 6, lines 26-35). McClure further indicates use of a “scanning television camera mounted remote from the operator station for scanning the approach to a patron station” (claim 12) and “said patron station includes means for conditioning the air temperature therein

for the better operation of the television means at said patron station” (claim 13). Clearly, the customer station (10) is located outside of a building. It follows that McClure does not disclose “positioning a frame” in an “interior wall” opening in the manner recited.

McClure does not disclose a customer station having a cover with a component opening

Claim 28 further recites “mounting a cover” having a “component opening” wherein the “transaction component is accessible through the component opening.” McClure does not disclose a cover having an opening in the manner recited. The alleged cover (36) does not include a component opening in the manner recited. Nor does McClure disclose that a transaction component is accessible when the cover is in overlying relation of a wall opening. Contrarily, when the alleged cover (36) in McClure is closed no component is accessible, because the alleged cover (36) does not include an opening.

The alleged cover (36) in McClure is actually a door. The door has no opening. It follows that the door has no “component opening.” When the door is in an overlying (closed) position no component is accessible. Furthermore, the door is not mounted in supporting connection with an interior wall of a building.

Thus, McClure does not overcome the admitted deficiencies in Casale/Bustos. Therefore, it follows that it would not have been obvious to have combined Casale, Bustos and McClure as alleged to have produced Appellants’ recited invention.

McClure desires the customer to remain outside of the building

McClure actually desires that the customers stay in their auto for convenience to the customer and safety for the teller (col. 1, lines 68-71; col. 2, lines 8-13). McClure requires that any customer station be kept external of the teller building. Hence, requiring a customer to come

inside a building would go directly against the explicit advantages of McClure. Also, there is no indication that McClure's building is large enough for customer usage (especially customers in their auto). Furthermore, even if McClure's customers were somehow permitted into the teller's building they would go to a teller window. They would not use a customer station (10), because the customer stations (10) are located outside of the building. Thus McClure, by explicitly teaching that the customer station is located outside, cannot overcome the deficiencies in Casale/Bustos.

Thus, McClure does not overcome the admitted deficiencies in Casale/Bustos. Therefore, it follows that it would not have been obvious to have combined Casale, Bustos and McClure as alleged to have produced Appellants' recited invention.

Not obvious to insert the customer station of McClure into Casale/Bustos

Nor has the Action explained how the customer station (10) in McClure, with the alleged frame and cover, could have been inserted inside of Casale's small building (10) (about the size of two typical parking spaces joined end-to-end). Nor would such an insertion have been obvious. As previously discussed, the building of Casale is too small in size to have included any customer station. The large customer station (10) of McClure further prevents such an insertion.

The combined teachings of McClure and Casale/Bustos would still lack the recited invention

Combining the teachings of McClure into the Casale/Bustos combination would not have produced the claimed invention. Including the teachings of McClure into the combination of Casale/Bustos, if somehow possible, would have at best produced adding a banking customer station to the area exterior of Casale's building (10). However, the alleged cover (36) and frame

of the banking customer station (10) would not be positioned upon an interior wall of Casale's building (10). Thus, McClure does not overcome the admitted deficiencies in Casale/Bustos. Therefore, it follows that it would not have been obvious to have combined Casale, Bustos and McClure as alleged to have produced Appellants' invention.

Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships that are specifically recited in claim 28. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It follows that the claims which depend from claim 28 are likewise allowable.

#### **Claim 43**

Claim 43 is an independent claim which is specifically directed to a system. The claim specifically recites that a customer station includes a "cover." The claim specifically recites that the "cover is movably mounted in supporting connection with the wall" of a building. The claim further recites that the "cover includes at least one opening" wherein a customer station "component is manually accessible through the at least one opening." The claim further recites that the customer station includes at least one component of a visual display; a CCTV camera; an audio transmitting device; an audio receiving device; and a carrier delivery and receiving device. The claim further recites that the movably mounted cover in a first position generally overlies a customer station component. The claim further recites that a customer station component is



enabled to be operated by a customer in the first position of the cover, and in a second position the cover is disposed from the component and the component rendered accessible for servicing.

Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships that are specifically recited in claim 43. The Action (page 7, last paragraph) also admits that “the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame and movable to enable access the opening in supporting to connect with the wall, a door frame, one hinge, a sub-frame, shelf, one storage location as specified in claims.” The Action (page 7, last paragraph) admits that the combination of Casale and Bustos fails to particularly disclose all of the recited features and relationships of claim 43. It is respectfully submitted that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships of a customer station cover in the manner recited.

The Action alleges that McClure teaches a customer station (10), a service station (18), a cover (36) mounted on the frame to enable access to the opening (26') (col. 4, lines 24-34), and a door frame with a door (36) connected. The Appellants disagree.

McClure does not disclose a system having a customer station component enabled to be operated by a customer through an opening in a cover movably mounted in supporting connection with a building wall. Nor does McClure disclose that the component is accessible for servicing when the cover is moved to a second position.

There is no indication in McClure of a customer station “cover” having at least one opening, or that a customer station “component is manually accessible through the at least one opening.” Nor is there any indication in McClure that a component is enabled to be operated by

a customer while a cover generally overlies the component. Where does McClure disclose a customer station cover having at least one opening? The alleged cover (36) does not have an opening. The alleged cover (36) in McClure is actually a door. The door has no opening. Where does McClure disclose that a customer station “component is manually accessible through the at least one opening” of a cover? McClure does not disclose that a component is manually accessible through an opening of the alleged cover (36). Where does McClure disclose a cover movable to a first position and a second position? Where does McClure disclose that a customer station component is accessible for servicing when the cover is moved to the second position? McClure does not disclose or suggest the recited customer station cover.

Furthermore, the alleged cover (36) of McClure, because it lacks an opening, does not permit operation of a component in the manner recited. McClure does not permit a component to be operated by a customer while a cover generally overlies the component. Contrarily, when the alleged cover (36) of McClure is in an overlying (closed) position no component is accessible to a customer, because the alleged cover (36) does not include an opening.

Therefore, McClure does not disclose or suggest the features and relationships that are not found in Casale/Bustos. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Therefore, it follows that it would not have been obvious to have combined Casale, Bustos and McClure as alleged to have produced Appellants’ invention.

Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited

references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that the claims which depend from claim 43 are likewise allowable.

#### **Claim 45**

Claim 45 is an independent claim which is specifically directed to a system. The claim specifically recites a building comprising "an interior area which includes an interior wall extending therein." The claim further recites "positioning a frame in the opening" of the interior wall. The claim further recites "positioning" a customer station "component in supporting connection with the frame." The claim further recites that the customer station includes at least one component of a customer visual display; a customer CCTV camera; a customer audio transmitting device; a customer audio receiving device; and a customer carrier delivery and receiving device.

An advantage of an exemplary embodiment of the invention is that the customer station can be readily installed in an interior of a building, in a manner similar to installing a door frame. The construction provides a customer station that occupies minimal floor space and is easy to install and service.

Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. The Action (page 7, last paragraph) also admits that "the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame and movable to enable access the opening in supporting to connect with the wall, a door frame, one hinge, a sub-frame, shelf, one storage location as

specified in claims.” The Action (page 7, last paragraph) admits that the combination of Casale and Bustos fails to particularly disclose all of the recited features and relationships of claim 45. It is respectfully submitted that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships of a customer station frame in the manner recited.

The Action is silent as to what element allegedly constitutes the frame for purposes of the rejection. Thus, Appellants have been given the undue burden of having to speculate as to what constitutes the alleged “frame.” It is respectfully submitted that neither Casale, Bustos, nor McClure disclose a frame in the manner recited.

The Action is silent as to what element constitutes the “frame” in Casale. A previous Action alleged that Casale’s drive-in window inherently had a “frame.” The current Action indicates that “the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on a frame.” The current Action also alleges that McClure’s customer station has a cover (36) mounted on a “frame.”

Casale does not disclose or suggest a frame as recited. Furthermore, even if it were possible for the drive-in window (22) to inherently have a frame, there is no indication in Casale that the drive-in window frame is in supporting connection with an interior wall in an interior area of a building as recited. At best the alleged drive-in window frame would extend in an exterior wall of Casale’s building (10). Nor is there any indication in Casale of a recited customer station “component in supporting connection with the frame.” Where does Casale disclose a recited customer station component (visual display; CCTV camera; audio transmitting device; audio receiving device; or a carrier delivery and receiving device) positioned in

supporting connection with the alleged window frame? Casale plainly does not disclose a customer station “component in supporting connection with the frame” in the manner recited.

Casale’s speaker/microphone (58) and display (62) are located at Casale’s inner housing (52). However, Casale’s inner housing (52) is separate and distant from Casale’s drive-in window. The inner housing (52) is part of a menu and display unit disposed on the lot containing the fast food building (10), preferably in the drive-up lanes (16, 18). The inner housing (52) is disposed at a distance from the pick-up window (22), otherwise the speaker/microphone (58) and display (62) would not be needed. Therefore, neither Casale’s speaker/microphone (58) nor display (62) can constitute a customer station component “in supporting connection with the frame.”

Furthermore, even if it were somehow possible to modify Casale so that a customer station component was positioned in supporting connection with the alleged window frame, it would be unclear how a customer could continue to use the window (22) as a pick-up window. The addition of a component to the alleged window frame would prevent use of the window in the manner described in the Casale reference. Such a modification would destroy the operability of the Casale system.

A reference teaching away from the recited invention does not support *prima facie* obviousness. It is improper to reconstruct the recited invention from the disclosure of the Appellants. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine 5 USPQ2d 1598-99 (Fed. Cir. 1988)*.

Furthermore, as previously discussed, the building (10) of Casale is too small in size to have included customer station features. Such small size renders Casale unfit for a customer station frame extending in an opening of an interior wall, and a customer station component in supporting connection with the frame. Nor would any purpose or benefit be derived from the addition of such features to Casale.

Furthermore, support for the building (10) of Casale is provided by four steel columns (29). The walls of the base level (12) appear to consist of panes of glass (24). Thus, the building (10) of Casale does not appear to have any interior walls that would permit a frame to be in an opening thereof and be in supporting connection therewith. Nor could Casale include a customer station component in supporting connection with the frame.

Bustos does not disclose or suggest a frame as recited. None of Bustos' embodiments disclose or suggest a customer component in supporting connection with a frame positioned in an opening of an interior wall of a building. Nor does Bustos disclose that the customer component is at least one of a customer visual display; a customer CCTV camera; a customer audio transmitting device; a customer audio receiving device; and a customer carrier delivery and receiving device as specifically recited in claim 45.

In Bustos' Figure 1 the dispensing unit (20) and its related panel (22) do not comprise a frame in the manner recited. Nevertheless, even if it were somehow possible for the dispensing unit (20) to have included a frame, the frame would still not be positioned in an opening of an interior wall of a building. This is because the dispensing unit (20) is not located in the building (15). Bustos also does not disclose that a customer station "component is in supporting connection with the frame" in the manner recited.

In Bustos' Figure 5D a guest is able to select an item from a menu displayed on a screen (106) of a cable television set (107) in a hotel room (104) (col. 13, lines 63-65). The television set (107) does not comprise a frame. Nor does the television set (107) comprise a frame positioned in an opening of an interior wall of a building. Nor is there disclosed a customer station component in supporting connection with a frame in the manner recited. Thus, Bustos cannot overcome the deficiencies in Casale. Therefore, it follows that it would not have been obvious to have combined Casale, Bustos, and McClure as alleged to have produced Appellants' invention.

The Action alleges that McClure teaches a customer station (10), a service station (18), a cover (36) mounted on the frame to enable access to the opening (26') (col. 4, lines 24-34), and a door frame with a door (36) connected.

McClure also does not disclose or suggest a frame as recited. As previously discussed, in McClure the customer station (10) is located outside of a building. McClure actually desires that the customers stay outside in their auto for convenience to the customer and safety for the teller (col. 1, lines 68-71; col. 2, lines 8-13). It follows that McClure does not disclose a frame in supporting connection with an interior wall of the building. It also follows that McClure does not disclose a recited customer station "component" in supporting connection with a frame which extends in an opening of an interior wall of a building. There is no indication in McClure of a customer station frame positioned in an opening of an interior wall of a building. Where does McClure disclose a customer station component positioned in supporting connection with a frame as recited? McClure does not disclose a customer station "component in supporting connection with the frame" in the manner recited. In McClure the customer station (10), and all

features thereof, is located outside of a building. Thus, McClure does not overcome the deficiencies in Casale/Bustos. Therefore, it follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' invention.

Combining the teachings of McClure into the Casale/Bustos combination would not have produced the claimed invention. Including the teachings of McClure into the combination of Casale/Bustos, if somehow possible, would have at best produced adding a banking customer station to the area exterior of Casale's building (10). However, the alleged frame of the banking customer station (10) would not be positioned in supporting connection with an interior wall in an interior area of Casale's building (10). McClure cannot overcome the deficiencies in Casale/Bustos. Therefore, it follows that it would not have been obvious to have combined Casale, Bustos and McClure as alleged to have produced Appellants' invention.

Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in claim 45, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that the claims which depend from claim 45 are likewise allowable.



**The Dependent Claims Are Not Obvious Over  
Casale in view of Bustos and McClure**

Each of the dependent claims 5-11, 14-16, 20-23, 29-36, 44, and 46 depend directly or indirectly from an independent claim, and it is asserted that these dependent claims are allowable on the same basis. Furthermore, each of the dependent claims additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. The applied references do not disclose or suggest the recited features and relationships of the dependent claims. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellants' invention. The Action has failed to establish that the features and relationships recited in the claims are shown in the applied references. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the features and relationships recited in the dependent claims. No prima facie obviousness has been established and the claims are further allowable on this basis. Thus, it is respectfully submitted that the dependent claims are further allowable.

The Action (page 7, last paragraph) admits that "the combination of Casale and Bustos fails to particularly disclose" all of the recited features and relationships of claims 5-11, 14-16, 20-23, 28, and 43-46.

**Claim 5**

Claim 5 depends from claim 4 and further recites that "the customer station further comprises a cover, and wherein the cover is movably mounted on the frame, and wherein the cover is movable to enable access to the opening." Thus, claim 5 recites a frame extending in an opening of an interior wall of a building, and wherein a customer station component is in supporting connection with the frame. Furthermore, a cover is movably mounted on the frame.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame.” It is respectfully submitted that McClure also does not disclose or suggest a cover in the manner recited. McClure does not disclose or suggest a cover movably mounted on a frame extending in an opening of an interior wall of a building. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited frame, customer station component, and cover relationship. Nothing in the applied art discloses or suggests these features and relationships. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants’ recited invention. It is respectfully submitted that the claim is further allowable on this basis.

#### **Claim 6**

Claim 6 depends from claim 38 and further recites that “the customer station further comprises a cover.” The cover is movably mounted in supporting connection with the interior wall. The cover overlies at least one component among the customer visual display, customer CCTV camera, and customer carrier device. The cover includes at least one opening. The one component is manually accessible through the at least one opening whereby it is enabled to be operated by a customer in the first position of the cover. In a second position the cover is disposed from the one component and the component is rendered accessible for servicing.

Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a movable cover including an opening in the manner recited, nor the recited cover and customer component relationship. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It

follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

#### **Claim 7**

Claim 7 depends from claim 4 and further recites that "the frame comprises a door frame." Thus, claim 7 recites a frame extending in an opening of an interior wall of a building, and wherein a customer station component is in supporting connection with the frame. Furthermore, the recited frame comprises a door frame. This feature enables a customer station to be installed in place of a door that is positioned in an interior building wall.

The Action admits that "the combination of Casale and Bustos fails to particularly disclose" a door frame. It is respectfully submitted that McClure also does not disclose or suggest a door frame in the manner recited. McClure does not disclose or suggest a frame extending in an opening of an interior wall of a building, wherein the frame comprises a door frame. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited door frame, customer station component, and interior wall relationship. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

#### **Claim 8**

Claim 8 depends from claim 7 and further recites "at least one hinge operatively connected to the door frame, and wherein the cover is movably mounted relative to the frame through the hinge." Thus, claim 8 recites a frame extending in an opening of an interior wall of a

building, and wherein a customer station component is in supporting connection with the frame. Furthermore, the frame comprises a door frame, and a hinge is operatively connected to the door frame. Additionally, a cover is movably mounted relative to the frame through the hinge.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame”, “a door frame”, and “one hinge.” It is respectfully submitted that McClure also does not disclose or suggest a cover in the manner recited. McClure does not disclose or suggest a cover movably mounted on a frame extending in an opening of an interior wall of a building.

McClure does not disclose or suggest a door frame in the manner recited. McClure does not disclose or suggest a frame extending in an opening of an interior wall of a building, wherein the frame comprises a door frame.

McClure does not disclose or suggest a hinge in the manner recited. McClure does not disclose or suggest a hinge such that a cover is movably mounted relative to a frame through the hinge.

Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited cover, door frame, and hinge relationship. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants’ recited invention.

### **Claim 9**

Claim 9 depends from claim 4 and further recites that “the frame bounds the opening, and further comprising a subframe in supporting connection with the frame, and wherein the subframe extends in the opening, and wherein at least one of the customer visual display, the customer CCTV camera, or the customer carrier device is in supporting connection with the subframe.” Thus, claim 9 recites a subframe extending in an opening of an interior wall of a building, and wherein at least one of the customer visual display, the customer CCTV camera, or the customer carrier device is in supporting connection with the subframe.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose” a subframe. It is respectfully submitted that McClure also does not disclose or suggest a subframe in the manner recited. McClure does not disclose or suggest a subframe extending in an opening of an interior wall of a building. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited subframe, customer station component, and interior wall relationship. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants’ recited invention.

### **Claim 10**

Claim 10 depends from claim 6 and further recites that “the cover includes a generally horizontally extending shelf, whereby a customer is enabled to conduct writing or other activities on the shelf.” As previously discussed, neither Casale nor Bustos nor McClure taken alone or in

combination disclose or suggest a movable cover including an opening, nor the recited cover and customer component relationship, in the manner recited in claim 6 from which claim 10 depends.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose” a shelf. It is respectfully submitted that McClure does not disclose or suggest a cover including an opening. It follows that McClure does not disclose or suggest a cover including a shelf in the manner recited. Additionally, McClure does not disclose or suggest that the cover includes a generally horizontally extending shelf. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited shelf. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants’ recited invention.

#### **Claim 11**

Claim 11 depends from claim 6 and further recites that “the cover includes at least one storage location, wherein articles are enabled to be stored in the storage location.” As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a movable cover including an opening, nor the recited cover and customer component relationship, in the manner recited in claim 6 from which claim 11 depends.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose” a storage location. It is respectfully submitted that McClure does not disclose or suggest a cover including an opening. It follows that McClure does not disclose or suggest a cover including a storage location in the manner recited. Additionally, McClure does not

disclose or suggest that articles are enabled to be stored in the storage location. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited storage location. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

#### **Claim 14**

Claim 14 depends from claim 38 and further recites "a video switching device." The video switching device is in operative connection with the SP station. The video switching device is operative to selectively establish video connections between the SP camera and the customer station display.

The Action is unclear as to the claimed "video switching device." The Action (page 4, lines 3-4 and 13-15) is unclear whether McClure or Casale is alleged to teach a video switching device. Appellants disagree as to any such teaching. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a video switching device in the manner recited. Neither reference teaches the capability of video "switching." It follows that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a video switching device in operative connection with an SP station. It follows that neither of the references taken alone or in combination disclose or suggest a video switching device operative to selectively establish video connections between an SP camera and a customer station display.

In regard to claim 14 the Action relies on McClure as allegedly showing a “switching device in operative connection with the service station (46).” However, McClure’s element (46) is actually a door closing solenoid. This solenoid does not relate to a video switching device. Nor does McClure disclose or suggest a video switching device in the manner recited. Nor does McClure disclose or suggest a video switching device in operative connection with an SP station. Nor does McClure disclose or suggest a video switching device operative to selectively establish video connections between an SP camera and a customer station display.

There is no indication that McClure discloses or suggests the recited features and relationships. Thus, McClure cannot overcome the deficiencies in Casale/Bustos.

As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants’ recited invention.

#### **Claim 15**

Claim 15 depends from claim 14 and further recites “a video material presenting device.” The video material presenting device is operative to generate video signals. The video switching device is in operative connection with the video presenting device. The video switching device is operative to selectively connect the video material presenting device to the customer visual display.

The Action is unclear as to the claimed “video material presenting device.” The Action (page 4, lines 3-4 and 13-15) is unclear whether McClure or Casale is alleged to teach a video material presenting device. Appellants disagree as to any such asserted teaching. Furthermore, if



the Action (page 4, lines 3-4) alleges the recited "video material presenting device" as the customer display of McClure, then how can this alleged customer display be selectively connectable to a "customer visual display"? That is, how can a display be selectively connectable to the same display?

There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' recited invention. The Action is also silent as to how a video material presenting device could be implemented into the combination of references to produce Appellants' invention. Thus, Appellants have been left to speculate as to how an unsupported video material presenting device could be implemented in the applied references. Thus, the Action procedurally fails to establish a prima facie case of obviousness.

Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a video material presenting device in the manner recited. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

#### **Claim 16**

Claim 16 depends from claim 15 and recites that "the video switching device is operative to selectively connect the customer visual display to either the video material presenting device or the SP CCTV camera."

In an embodiment of the invention, the video material presenting device is able to provide the customer station some video information that is intended to be of interest to the customers who use the system. The video switching device may operate to present the video material on the

display of the customer station, except when the customer and the service provider are in communication.

Neither Casale nor Bustos nor McClure disclose or suggest a video switching device. Thus, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a video switching device in the manner recited. It follows that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a video switching device operative to selectively connect a customer visual display to either a video material presenting device or an SP camera.

In regard to claim 16 the Action relies on McClure as allegedly showing a “switching device in operative connection with the service station (46).” However, McClure’s element (46) is actually a door closing solenoid. This solenoid does not relate to a video switching device. Nor does McClure disclose or suggest a video switching device in the manner recited.

There is no indication that McClure discloses or suggests the recited features and relationships. Thus, McClure cannot overcome the deficiencies in Casale/Bustos.

As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants’ recited invention.

#### **Claim 20**

Claim 20 depends from claim 38 and further recites that “the customer station is produced by a method.” The method includes producing an opening in the wall, positioning a frame in the

opening in supporting connection with the interior wall, and positioning the at least one customer station component in supporting connection with the frame.

Therefore, the frame is in supporting connection with the interior wall and is positioned in the wall opening. Furthermore, a customer component (visual display, camera, audio transmitting device, audio receiving device, or carrier delivery and receiving device) is in supporting connection with the frame.

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a frame in the manner recited. Neither reference teaches a frame in supporting connection with an interior wall. It follows that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a frame in an opening of an interior wall of a building, and wherein a customer station component is in supporting connection with the frame. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

#### **Claim 21**

Claim 21 depends from claim 20 and further recites that "the customer station further comprises a cover." The method of producing the customer station further includes movably mounting the cover in supporting connection with the interior wall. The cover is movable between a first position (overlying the opening in the interior wall) and a second position (disposed from the opening).

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover in the manner recited. The Action alleges that McClure teaches a cover (36). The alleged cover (36) in McClure is actually referenced as a door (col. 4, lines 24-33). Furthermore, the alleged cover (36) at McClure's banking customer station (10) is not in supporting connection with an interior wall. Thus, McClure cannot overcome the deficiencies in Casale/Bustos. It follows that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover movable between a first position and a second position in the manner recited. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

## **Claim 22**

Claim 22 depends from claim 21 and further recites that "the step of movably mounting the cover comprises operatively connecting the cover to the frame through a hinge."

The Action admits that "the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame", and "one hinge." It is respectfully submitted that McClure also does not disclose or suggest a cover in the manner recited. McClure does not disclose or suggest a cover operatively connected to a frame. McClure does not disclose or suggest a hinge in the manner recited. McClure does not disclose or suggest a cover operatively connected to a frame through a hinge. McClure does not disclose or suggest an interior cover, frame, or hinge.

Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited cover, frame, and hinge relationship. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

### **Claim 23**

Claim 23 depends from claim 21 and further recites that "the first position of the cover is in abutting relation with the wall and generally extends in surrounding relation of the frame." The cover in the first position is also overlying the opening in the interior wall (claim 21).

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover in the manner recited. The Action alleges that McClure teaches a cover (36). The alleged cover (36) in McClure is actually referenced as a door (col. 4, lines 24-33). Furthermore, the alleged cover (36) at McClure's banking customer station (10) is not in supporting connection with an interior wall. Thus, McClure cannot overcome the deficiencies in Casale/Bustos. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

### **Claim 29**

Claim 29 depends from claim 28 and further recites "releasibly mounting the cover in supporting connection with the wall."

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover in the manner recited. Furthermore, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest releasibly mounting the cover in supporting connection with the interior wall. The Action alleges that McClure teaches a cover (36). The alleged cover (36) in McClure is actually referenced as a door (col. 4, lines 24-33). Furthermore, the alleged cover (36) at McClure's banking customer station (10) is not in supporting connection with an interior wall. Thus, McClure cannot overcome the deficiencies in Casale/Bustos.

Furthermore, as previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover including a component opening in the manner recited, nor the recited cover and transaction component relationship. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

### **Claim 30**

Claim 30 depends from claim 28 and further recites "movably mounting the cover in connection with the wall through a hinge connection." The cover is movable between a first position overlying the wall opening and a second position wherein the cover is disposed from the wall opening.

The Action admits that "the combination of Casale and Bustos fails to particularly disclose "one hinge." The Action (page 8, line 7) alleges that a hinge is inherent in the art. The Appellants disagree that a hinge is inherent in the manner recited. Additionally, the Action has

not shown that McClure or any other reference discloses or suggests a cover, interior wall, and hinge relationship in the manner recited. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited cover, interior wall, and hinge relationship.

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover in the manner recited. The Action alleges that McClure teaches a cover (36). The alleged cover (36) in McClure is actually referenced as a door (col. 4, lines 24-33). Furthermore, the alleged cover (36) at McClure's banking customer station (10) is not in supporting connection with an interior wall. Thus, McClure cannot overcome the deficiencies in Casale/Bustos.

Furthermore, as previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover including a component opening in the manner recited, nor the recited cover and transaction component relationship. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

### **Claim 31**

Claim 31 depends from claim 30 and further recites "releasibly locking the cover." The cover and the frame may be operatively engaged in an area disposed from the hinge connection.

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover or a frame in the manner recited. It follows that neither

Casale nor Bustos nor McClure taken alone or in combination disclose or suggest releasibly locking a cover in the manner recited.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame.” It is respectfully submitted that McClure also does not disclose or suggest a cover in the manner recited. McClure also does not disclose or suggest engaging a cover and a frame. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants’ recited invention.

### **Claim 32**

Claim 32 depends from claim 31 and further recites that “when the cover is moved to the first position the cover extends in generally abutting relation with the wall and in surrounding relation of the frame.”

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover, interior wall, and frame relationship in the manner recited.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose a cover is movably mounted on the frame.” As previously discussed, McClure also does not disclose or suggest a cover, interior wall, and frame in the manner recited. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is



further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

### **Claim 33**

Claim 33 depends from claim 28 and recites framing the interior wall opening with an "opening bounding frame." The claim further recites "positioning the transaction component in supporting connection with the bounding frame." Claim 28 relates to positioning a frame in an interior wall opening in supporting connection with the interior wall, and positioning at least one transaction component in supporting connection with the frame.

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest positioning a frame in an interior wall opening in supporting connection with the interior wall (claim 28) in the manner recited. It follows that neither reference discloses nor suggests framing the interior wall opening with an opening bounding frame. It further follows that neither reference discloses nor suggests positioning a transaction component in supporting connection with the bounding frame. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

### **Claim 34**

Claim 34 depends from claim 33 and recites "supporting a subframe in supporting connection with the bounding frame." The claim further recites positioning a transaction component in supporting connection with the subframe.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose” a subframe. It is respectfully submitted that McClure also does not disclose or suggest a subframe in the manner recited. McClure does not disclose or suggest a subframe in supporting connection with a bounding frame, where an interior wall opening is framed with the bounding frame.

Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited subframe, bounding frame, and interior wall relationship. It follows that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest positioning a transaction component in supporting connection with the subframe. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants’ recited invention.

**Claim 35**

Claim 35 depends from claim 33 and recites that “the bounding frame comprises a door frame.” The claim further recites that the interior wall opening is framed by the door frame.

The Action admits that “the combination of Casale and Bustos fails to particularly disclose” a “door frame.” It is respectfully submitted that McClure also does not disclose or suggest a door frame in the manner recited. Nor does McClure disclose or suggest an interior wall opening framed by the door frame. Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited door frame and interior wall relationship. As nothing

in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

### **Claim 36**

Claim 36 depends from claim 35 and recites that "the door frame includes two generally parallel vertically extending upright portions." The claim further recites engaging a subframe, extending in the interior wall opening, between the two upright portions. The claim further recites positioning a transaction component in supporting connection with the subframe.

The Action admits that "the combination of Casale and Bustos fails to particularly disclose" a subframe. It is respectfully submitted that McClure also does not disclose or suggest a subframe in the manner recited. McClure does not disclose or suggest a subframe between two upright portions of a door frame. Nor does McClure disclose or suggest a transaction component in supporting connection with the subframe.

Thus, McClure cannot overcome the admitted deficiencies in Casale/Bustos. Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the recited subframe, door frame, and interior wall relationship. It follows that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest positioning a transaction component in supporting connection with the subframe.

Furthermore, the Action is silent as to the claimed "upright portions." There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention. The Action is also silent as to how "upright portions" could be

implemented into the combination of references to produce Appellants' invention. Thus, Appellants have been left to speculate as to how "upright portions" not shown in any cited reference could be implemented in the applied references. Thus, the Action procedurally fails to establish a prima facie case of obviousness.

As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

#### **Claim 44**

Claim 44 depends from claim 43 and recites that "the wall is an interior wall extending in an interior area of the building." Claim 44 further recites that a customer station "component is positioned within the interior area in supporting connection with the interior wall."

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a cover (claim 43) in the manner recited. The Action alleges that McClure teaches a cover (36). However, the alleged cover (36) at McClure's banking customer station (10) is not in supporting connection with an interior wall of a building. Nor does the alleged cover (36) in McClure include an opening. Nor does McClure disclose or suggest a customer station component positioned within an interior area of a building in supporting connection with the interior wall. Thus, McClure cannot overcome the deficiencies in Casale/Bustos. It follows that neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest the cover, interior wall, and component relationship in the manner recited. As nothing in the applied art discloses or suggests these features and

relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

**Claim 46**

Claim 46 depends from claim 45 and further recites producing a plurality of customer stations, where each customer station includes a frame in supporting connection with an interior wall of the building. It is further recited that each customer station includes at least one component of a customer visual display, a customer CCTV camera, a customer audio transmitting device, a customer audio receiving device, and a customer carrier delivery and receiving device. The at least one component of each customer station is in supporting connection with the customer station frame.

Claim 45 recites positioning a frame in an opening in an interior wall of a building. Claim 45 further recites positioning the frame in supporting connection with the interior wall, and positioning a customer station component in supporting connection with the frame. Claim 46 further recites a plurality of customer stations, and that each customer station includes a frame in supporting connection with an interior wall of the building. Claim 46 additionally recites that a component of each customer station is in supporting connection with that station's frame.

As previously discussed, neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest positioning a frame in an opening of an interior wall and in supporting connection with the interior wall in the manner recited. It follows that neither reference taken alone or in combination discloses or suggests positioning at least one customer

station component in supporting connection with the frame. It further follows that neither reference taken alone or in combination discloses or suggests that the customer station component is either a visual display, a customer camera, a customer audio transmitting device, a customer audio receiving device, or a customer carrier delivery and receiving device. It further follows that neither reference taken alone or in combination discloses or suggests a plurality of customer stations, with each customer station including a frame in supporting connection with an interior wall of the building, and a component of each customer station in supporting connection with that station's frame.

As previously discussed, the Action is unclear as to what element constitutes the frame in the rejection. Thus, Appellants have been given the undue burden of having to speculate as to what constitutes the recited "frame." Thus, Appellants have been left to speculate as to how a frame as recited could be implemented in the applied references. Thus, the Action procedurally fails to establish a prima facie case of obviousness. It is respectfully submitted that neither Casale, Bustos, or McClure disclose a frame in the manner recited. There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' recited invention. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, and McClure to have produced Appellants' recited invention.

**Claim 17 Is Not Obvious Over  
Casale in view of Bustos and McClure and Kaehler**

**Claim 17**

Claim 17 was rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale in view of Bustos and McClure and further in view of Kaehler. The Action admits that “the combination of Casale, Bustos and McClure fails to particularly disclose a computer for storing data base at the service station.”

Claim 17 depends from claim 16 and further recites “a video material presenting device.” The video material presenting device comprises a computer. The computer is in operative connection with a data store. The data store includes data representative of video material. The computer is also in operative connection with a data transmission line. The video material is changeable through the data transmission line.

The Action is unclear as to the claimed “a video material presenting device.” There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants’ invention. The Action is also silent as to how a video material presenting device could be implemented into the combination of references to produce Appellants’ recited invention. Thus, Appellants have been left to speculate as to how a video material presenting device not shown in the cited art could be implemented in the applied references. Thus, the Action procedurally fails to establish a prima facie case of obviousness.

Neither Casale nor Bustos nor McClure taken alone or in combination disclose or suggest a video material presenting device in the manner recited. Furthermore, the Action admits that “the combination of Casale, Bustos and McClure fails to particularly disclose a computer for storing data base at the service station.”

The Action alleges that it would be obvious to modify Kaehler's computer (26) to the service station of the combination of Casale, Bustos and McClure for the purpose of storing data.

The Appellants disagree. Kaehler's alleged computer (26) is actually a data entry terminal (col. 5, line 50). Kaehler does disclose a central control computer (16) (col. 6, lines 27-28). However, Kaehler does not disclose or suggest the recited computer, data store, and video material relationship. Furthermore, Kaehler is directed to a fuel dispenser system for selling fuel. Kaehler is non-analogous art. Even if it were somehow possible for Kaehler to have taught the recited relationship, the Action is silent as to how Kaehler's fuel dispenser system could be implemented into the combination of Casale, Bustos, and McClure. For example, it is unclear how Kaehler's fuel dispenser system could be implemented into Casale's drive-thru fast food establishment. Having food and fuel close together raises the possibility of health concerns. Again, the Action procedurally fails to establish a prima facie case of obviousness.

Neither Casale, Bustos, McClure, nor Kaehler taken alone or in combination disclose or suggest the recited features and relationships. As nothing in the applied art discloses or suggests these features and relationships, it is respectfully submitted that the claim is further allowable on this basis. It follows that it would not have been obvious to have combined Casale, Bustos, McClure, and Kaehler to have produced Appellants' recited invention.

## **CONCLUSION**

As explained above, each of the pending claims specifically recite features, relationships, or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of



the applied art so as to produce Appellant's invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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